

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Application of: Shimon S. Shmueli

Serial No. 09/802,634

Filed: 03/09/2001

For: **ACCOUNT PORTABILITY FOR COMPUTING**

Examiner: Fadok, Mark A.

Art Unit: 3625

Mail Stop Appeal Brief – Patents

Commissioner for Patents

PO Box 1450

Alexandria, VA 22313-1450

Sir:

An **APPEAL BRIEF** is filed herewith. Appellant encloses a payment in the amount of \$500.00 as required by 37 C.F.R. § 1.17(c). If any additional fees are required in association with this appeal brief, the Director is hereby authorized to charge them to Deposit Account 50-1732, and consider this a petition therefor.

**APPEAL BRIEF**

**(1) REAL PARTY IN INTEREST**

The real party in interest is SanDisk IL Ltd., located at 7 Atir Yeda Street, Kfar Saba, Israel. SanDisk acquired M-Systems Flash Disk Pioneers Limited, the assignee of record of the present invention, in late 2006.

**(2) RELATED APPEALS AND INTERFERENCES**

This appeal is related to an appeal brief filed for the above-referenced application on January 3, 2005 and a revised appeal brief filed on October 12, 2005. These appeal briefs addressed the Patent Office's previous rejections, which were based on references not being used in the current rejections. The Board of Patent Appeals and Interferences issued a decision on March 28, 2006 in that appeal, reversing the Examiner's previous rejections (attached in Appendix A). The Patent Office issued new rejections based on newly cited references which are the subject of this appeal.

### **(3) STATUS OF CLAIMS**

Claims 1-7, 9-19, and 21-27 were rejected with the rejection made final on March 8, 2007.

Claims 8, 20, and 28 were cancelled.

Claims 1-7, 9-19, and 21-27 are pending and are the subject of this appeal.

### **(4) STATUS OF AMENDMENTS**

All amendments have been made to the best of Appellant's knowledge. No amendments have been made after the final rejection on March 8, 2007.

### **(5) SUMMARY OF CLAIMED SUBJECT MATTER**

In the following summary, Appellant has noted where in the Specification certain subject matter exists. Appellant wishes to point out that these citations are for demonstrative purposes only and that the Specification may include additional discussion of the various elements, citations to which are not pointed out below. Thus, the noted citations are in no way intended to limit the scope of the pending claims.

The claimed invention is designed to simplify a user's interaction with a computing device, and is particularly designed to facilitate use of web sites visited by the computing device during the course of a computing session. Specifically, the user carries a portable memory device (10A), such as a card (10B), that has computer readable memory (18) associated therewith. The portable memory device has an appropriate interface (24) through which it may communicate with the computing device (12) during the computing session. The memory contains computer readable software (20) that automatically executes on the computing device (12) during the computing session (Specification, p. 6, lines 3-25; and p. 6, line 33 through p. 7, line 3). In particular, the automatically executing software determines that the user is using a web browser and has visited a web site that has a web page having financial account fields thereon. The software on the portable device automatically fills in the financial account fields to facilitate the completion of a web-based transaction (Figure 3B, step 122; see also Specification, p. 21, line 21 through p. 22, line 31). In an exemplary embodiment, credit card information and shipping information may be filled in by the automatically executing software of the claimed invention.

To further assist the user, the software of the claimed invention also removes the financial information from the various memories of the computing device (Figure 3B, step 130; see also, Specification, p. 11, line 26 through p. 12, line 11). For example, cookies are deleted, caches are cleared, and other temporary memory buffers are purged so that a subsequent user of the computing device cannot retrieve private information about the previous user.

Claim 1 recites a portable device (Figure 1, element 10; and Figures 2A-2C) comprising:

- a) a body (such as the body of 10A, Figure 2A; the body of 10B, Figure 2B; or the body of 10C, Figure 2C);
- b) memory (Figure 1, memory 18) within the body containing software (Figure 1, software 20) and financial account information;
- c) an interface (such as Figure 1, key interface 24) associated with the memory and adapted to facilitate interaction with the host computing device (such as Figure 1, host 12) during a computing session;
- d) the software adapted to execute on the host computing device to instruct the host computing device to:
  - i) recognize financial account fields in a web page during a browsing session (Specification, p. 2, lines 18-24);
  - ii) fill in the financial account fields in the web page with the financial account information from the portable device to facilitate a web-based transaction (Specification, p. 2, line 18 through p. 3, line 9; and p. 21, line 21 through p. 22, line 31; see also Figure 3B, step 122);
  - iii) automatically execute on the host computing device in association with the computing session (Specification, p. 6, lines 3-25; and p. 6, line 33 through p. 7, line 3); and
  - iv) in association with termination of the computing session, instruct the host computing device to remove records pertaining to the computing session from the host computing device to enhance privacy associated with the computing session (Specification, p. 11, line 26 through p. 12, line 11; see also Figure 3B, step 130).

Claim 13 is similar to claim 1, albeit as a computer readable medium with software having instructions to perform the same steps as recited in claim 1. That is, the software executes on the computing device, recognizes account fields on web pages during browsing

sessions, fills in the fields with data from the memory, and performs the clean up function.

Claim 13 recites a computer readable medium (Specification, p. 4, lines 8-13) including software (Figure 1, software 20) to reside on a portable device (Figure 1, element 10; and Figures 2A-2C) capable of interacting with a plurality of host computing devices (such as Figure 1, host 12), the software comprising instructions for the host computing device to:

- execute on the host computing device during a computing session (Specification, p. 6, lines 3-25; and p. 6, line 33 through p. 7, line 3);

- recognize financial account fields in a web page during a browsing session (Specification, p. 2, lines 18-24); and

- fill in the financial account fields in the web page with financial account information stored on the portable device to facilitate a web-based transaction (Specification, p. 2, line 18 through p. 3, line 9; and p. 21, line 21 through p. 22, line 31; see also Figure 3B, step 122),

- said software further adapted to execute automatically on the host computing device in association with the computing session (Specification, p. 6, lines 3-25; and p. 6, line 33 through p. 7, line 3); and

- in association with termination of the computing session, instruct the host computing device to remove records pertaining to the computing session from the host computing device to enhance privacy associated with the computing session (Specification, p. 11, line 26 through p. 12, line 11; see also Figure 3B, step 130).

Claim 21 is likewise similar to claim 1, albeit as a pure method claim. The method includes executing software on the computing device, recognizing account fields on web pages during browsing sessions, filling in the fields with data from the memory, and performing the clean up function. Claim 21 recites a method for facilitating a web-based transaction using a portable device (Figure 1, element 10; and Figures 2A-2C) capable of interacting with a plurality of host computing devices (such as Figure 1, host 12), the method comprising:

- executing software (Figure 1, software 20) resident on the portable device on a host computing device in association with a computing session (Specification, p. 6, lines 3-25; and p. 6, line 33 through p. 7, line 3), the software adapted to instruct the host computing device:

- recognize financial account fields in a web page during a browsing session (Specification, p. 2, lines 18-24);

fill in the financial account fields in the web page with financial account information stored on the portable device to facilitate a web-based transaction (Specification, p. 2, line 18 through p. 3, line 9; and p. 21, line 21 through p. 22, line 31; see also Figure 3B, step 122), wherein the software is further adapted to execute automatically on the host computing device in association with the computing session (Specification, p. 6, lines 3-25; and p. 6, line 33 through p. 7, line 3); and

remove records pertaining to the computing session from the host computing device to enhance privacy associated with the computing session in association with termination of the computing session (Specification, p. 11, line 26 through p. 12, line 11; see also Figure 3B, step 130).

Certain dependent claims are argued to have separate grounds for patentability. Claim 4 depends from independent claim 1; claim 16 depends from independent claim 13; claim 24 depends from independent claim 21. Each of claims 4, 16, and 24 recites the further limitation of “wherein the portable device stores login information for a web site associated with the web-based transaction and the software is further adapted to instruct the host computing device to determine if login information is necessary for the web site and provide the login information upon entering the web site.” (Specification, p. 3, lines 19-24; and p. 18, line 29 through p. 20, line 19).

Claims 5 depends from independent claim 1; claim 17 depends from independent claim 13; claim 25 depends from independent claim 21. Each of claims 5, 17, and 25 recite the further limitation of “wherein a bookmark for the web site is stored on the portable device and the software is further adapted to instruct the host computing device to make the bookmark accessible by a browser running on the host computing device such that a user may use the bookmark to efficiently access the web site via the browser.” (Specification, p. 3, lines 25-32; and p. 20, line 20 through p. 21, line 20).

## **(6) GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL**

**A.** Whether claims 1-3, 6, 7, 9-15, 18, 19, 21-23, 26, and 27 were properly rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,884,271 to Pitroda (hereinafter “Pitroda”) in view of U.S. Patent No. 6,950,857 B1 to Arnold (hereinafter “Arnold”) in view of

U.S. Patent Application Publication No. 2003/0014371 A1 to Turgeon (hereinafter “Turgeon”) and further in view of Official Notice.

**B.** Whether claims 1-7, 9-19, and 21-27 were properly rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Application Publication No. 2002/0029254 A1 to Davis et al. (hereinafter “Davis”) in view of Arnold and Turgeon and further in view of Official Notice.

**C.** Whether claims 4, 5, 16, 17, 24 and 25 were properly rejected under 35 U.S.C. § 103(a) as being unpatentable over Pitroda in view of Turgeon in view of Inala and further in view of Official Notice.

## **(7) ARGUMENT**

### **A. Introduction**

The Patent Office has not shown where all the elements of the claims are shown with sufficient particularity to sustain an obviousness rejection. None of the cited references, either alone or in combination, teach or suggest the following elements in combination:

- 1) software within the body of the portable device that is adapted to execute on the host computing device to instruct the host computing device;
- 2) the software adapted to execute on the host computing device to instruct the host computing device to recognize and fill in financial account fields in a web page with financial account information from the portable device;
- 3) the software adapted to automatically execute on the host computing device in association with the computing session; and
- 4) the software adapted to execute on the host computing device to instruct the host computing device to remove records pertaining to the computing session from the host computing device upon termination of the computing session.

Moreover, the Patent Office has failed to provide an apparent reason why one of ordinary skill in the art would combine the references in the manner asserted by the Patent Office.

For the foregoing reasons, Appellant requests that the Board reverse the Examiner and instruct the Examiner to allow the claims for these reasons.

## **B. Summary of the References**

### **1. U.S. Patent No. 5,884,271 to Pitroda**

Pitroda is directed to a universal electronic transaction card ("UET card") that is capable of serving as a number of different credit cards, bank cards, ID cards, employee cards, medical and health care management cards, and the like (Pitroda, Abstract). The UET card includes storage elements, an input interface, a processor, a display, and a communications interface. *Ibid.* In one embodiment, transactional and account information may be transferred between the UET card and a personal or mainframe computer. *Ibid.* Pitroda discloses that a home PC may interact with the UET card to perform transactional analysis needed for tax review, summary, or budgeting purposes (Pitroda, col. 10, lines 40-50). Pitroda discloses software for interfacing between the home PC and the UET card for reading information from the card, but it does not indicate that this software is resident on the UET card. Moreover, the software disclosed in Pitroda is just for reading information from the card; there is no mention of the software instructing the host computer to do anything.

### **2. U.S. Patent No. 6,950,857 B1 to Arnold**

Arnold is directed to a secure simplified transaction processing method for a palmtop computer (Arnold, Abstract). In Arnold, there is a site map database that contains information which maps the fields of a personal information database to frames of a Web page. A robot program at a data center where the databases are located correlates the personal information fields with the frames of the Web page and sends the personal information to a palmtop computer. The palmtop computer uses the information to automatically populate the frames of a Web clipping that represents a Web page (Arnold, col. 1, lines 47-61; see also Figure 6). The Web clipping is not the same as a Web page (*Id.* at col. 6, lines 13-64). The robot program in Arnold that correlates the personal information fields with the frames of the Web page is located in data center 320 (Arnold, Figure 6; see also col. 6, line 65 through col. 7, line 12). In Arnold, the robot program in the data center, not the host computing device, populates the fields of the Web clipping (*Id.* at col. 8, lines 26-35). In Arnold, the personal information comes from personal information database 350 in data center 320 (*Id.* at Figure 6; see also col. 7, lines 13-17; and col. 8, lines 30-32). The personal information is stored in the personal information database

350 because it is considered undesirable to store confidential information within the palmtop computer (*Id.* at col. 7, lines 13-21).

### **3. U.S. Patent Application Publication No. 2003/0014371 A1 to Turgeon**

Turgeon relates to a system and method for providing secure access over public communication lines using encrypted information on a removable, portable storage medium (Turgeon, Abstract). Turgeon is concerned with the security of sending credit card or other financial information over a public data network. Customers use a CD-ROM having an encrypted version of the critical credit card and other financial details. When the customer executes an e-commerce transaction, a purchase request, along with the encrypted card details, is sent to the merchant. The merchant provides the payment details, along with the encrypted card details, to a decryption processor that transforms the merchant's message into a decrypted, conventional payment order recognizable by the conventional banking system. *Ibid.* Turgeon does disclose that during the Web transaction, after the information is retrieved from the CD, and the information and the PIN are transferred to the merchant payment module at the Web host server, a memory in the PC is flushed to erase data used by the active Web module, which expires on the PC (Turgeon, paragraph 0052). However, the flushing of the memory in Turgeon is not equivalent to the removal of records pertaining to the computing session from the host computing device to enhance privacy associated with the computing session. Moreover, in Turgeon, it is not the **software provided by the portable device** that instructs the host computing device to remove records pertaining to the computing device. Finally, the flushing of the memory in Turgeon is not done "in association with termination of the computing session." Instead, in Turgeon, after the flushing of the memory is done, the Web host server continues the transaction (*Ibid.*; see also Figures 5b-5d, steps 522-570).

### **4. U.S. Patent Application Publication No. 2002/0029254 A1 to Davis**

Davis is directed to a method and system for controlling and managing the storage and retrieval of personal information in a computer network (Davis, Abstract). Davis discloses a smart card device 410 that is configured with the functionality of a server to provide for operation and control of multiple applications (Davis, paragraph 0036). The smart card device can be configured through an interface with the access device 430. As a result, the smart card



device 410 can organize, manage, and store information locally in a portable device. The applications on the smart card act locally and do not execute on a host device to instruct the host device to perform the steps of the claimed invention. Davis discloses that the smart card device 410 may provide user data to data management component 450 of the access device 430 (Davis, paragraph 0043). The smart card device of Davis merely provides data to the access device. Similarly, Davis discloses that a user financial application 604 on the smart card device can be used to import financial information to another web site or vendor (Davis, paragraph 0059). However, there is no teaching or suggestion that the user financial application 604 is executed on the access device to instruct the access device to import the financial device.

#### **5. U.S. Patent No. 6,199,077 to Inala**

Inala is directed to a method and system for gathering summary information from users or enterprise-selected Web sites and presenting the information as HTML to the user using either a push or pull technology (Inala, col. 1, lines 16-22). Inala discloses a portal server that includes a software agent configured to do summary searches for subscribers based on Internet destinations provided by the subscribers, to retrieve information from such destinations based on pre-programmed site information, and to download the summary information to the subscriber (Inala, Abstract). In a preferred embodiment of Inala, autologins are accomplished for a subscriber at Internet destinations by use of pre-stored configuration information (Inala, Abstract).

#### **C. Legal Standards for Establishing Obviousness**

Section 103(a) of the Patent Act provides the statutory basis for an obviousness rejection and reads as follows:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Courts have interpreted 35 U.S.C. § 103(a) as a question of law based on underlying facts. As the Federal Circuit stated:

Obviousness is ultimately a determination of law based on underlying determinations of fact. These underlying factual determinations include: (1) the scope and content of the prior art; (2) the level of ordinary skill in the art; (3) the differences between the claimed invention and the prior art; and (4) the extent of any proffered objective indicia of nonobviousness.

*Monarch Knitting Mach. Corp. v. Sulzer Morat GmbH*, 45 U.S.P.Q.2d (BNA) 1977, 1981 (Fed. Cir. 1998) (internal citations omitted).

Once the scope of the prior art is ascertained, the content of the prior art must be properly combined. The mere fact that references can be combined does not render the resultant combination obvious. MPEP § 2143.01. An obviousness inquiry requires looking at a number of factors, including the background knowledge possessed by a person having ordinary skill in the art, to determine whether there was an apparent reason to combine the elements of the prior art in the fashion claimed by the present invention. *KSR Int'l v. Teleflex, Inc.*, No. 04-1350, slip op. at 14 (U.S., Apr. 30, 2007). For the Patent Office to combine references in an obviousness rejection, the Patent Office must identify a reason why a person of ordinary skill in the art would have combined the references. *Id.* at 15. If the Patent Office cannot establish obviousness, the claims are allowable.

Even if the Patent Office is able to articulate and support a suggestion to combine the references, it is impermissible to pick and choose elements from the prior art while using the application as a template. *In re Fine*, 837 F.3d 1071 (Fed. Cir. 1988). To reconstruct the invention by such selective extraction constitutes impermissible hindsight. *In re Gorman*, 933 F.2d 982 (Fed. Cir. 1991). After the combination has been made, for a *prima facie* case of obviousness, the combination must still teach or fairly suggest all of the claim elements. *In re Royka*, 490 F.2d 981 (C.C.P.A. 1974); MPEP § 2143.03.

Some elements may be inherent within the reference. “To establish inherency, the extrinsic evidence ‘must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill.’” *In re Robertson*, 169 F.3d 743, 745 (Fed. Cir. 1999) (quoting *Cont'l Can Co. v. Monsanto Co.*, 948 F.2d 1264, 1268 (Fed. Cir. 1991)). “The mere fact that a certain thing may result from a given set of circumstances is not sufficient.” *Id.* (citation and quotation omitted). Thus, the possibility that an element may be derived from the reference is insufficient to establish that said element is inherent to the reference.

Whether an element is implicitly or explicitly taught by a reference or combination of references is open to interpretation. While the Patent Office is entitled to give claim terms their broadest reasonable interpretation, this interpretation is limited by a number of factors. First, the interpretation must be consistent with the specification. *In re Hyatt*, 211 F.3d 1367, 1372 (Fed. Cir. 2000); MPEP § 2111. Second, the broadest reasonable interpretation of the claims must also be consistent with the interpretation that those skilled in the art would reach. *In re Cortright*, 165 F.3d 1353, 1359, (Fed. Cir. 1999); MPEP § 2111. Finally, the interpretation must be reasonable. *In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1369 (Fed. Cir. 2004); MPEP § 2111.01. This means that the words of the claim must be given their plain meaning unless Appellant has provided a clear definition in the specification. *In re Zletz*, 893 F.2d 319, 321 (Fed. Cir. 1989).

A prior art reference must be considered in its entirety, including disclosures which teach away from the claims. MPEP §2141.02, citing *W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 721 F.2d 1540 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984). In addition, a proposed combination or modification of references cannot render the prior art unsatisfactory for its intended purpose, and cannot change the principle of operation of a reference. MPEP § 2143.01.

If a claim element is missing after the combination is made, then the combination does not render obvious the claimed invention, and the claims are allowable. As stated by the Federal Circuit, “[if] the PTO fails to meet this burden, then the Appellant is entitled to the patent.” *In re Glaug*, 283 F.3d 1335, 1338 (Fed. Cir. 2002).

**D. Claims 1-3, 6, 7, 9-15, 18, 19, 21-23, 26, and 27 Are Patentable Over Pitroda in View of Arnold and Turgeon and Further in View of Official Notice**

The Patent Office has rejected claims 1-3, 6, 7, 9-15, 18, 19, 21-23, 26, and 27 under 35 U.S.C. § 103 as being unpatentable over Pitroda in view of Arnold, Turgeon, and further in view of Official Notice (Final Office Action mailed March 8, 2007, p. 3).

Before addressing the rejections, Appellant provides a brief overview of the invention. The claimed invention is designed to simplify a user’s interaction with a computing device, and is particularly designed to facilitate use of web sites visited by the computing device during the course of a computing session. Specifically, the user carries a portable memory device that has computer readable memory associated therewith. The portable memory device has an

appropriate interface through which it may communicate with the computing device during the computing session. The memory contains computer readable software that automatically executes on the computing device during the computing session. In particular, the automatically executing software determines that the user is using a web browser and has visited a web site that has a web page having financial account fields thereon. The software on the portable device automatically fills in the financial account fields to facilitate the completion of a web-based transaction. In an exemplary embodiment, credit card information and shipping information may be filled in by the automatically executing software of the claimed invention. To further protect the user's privacy, the software of the claimed invention subsequently removes the financial information from the computing device. For example, cookies are deleted, caches are cleared, and other temporary memory buffers are purged so that a subsequent user of the computing device cannot retrieve private information about the previous user.

To establish *prima facie* obviousness, the Patent Office must show where each and every element of the claim is taught or suggested in the combination of references. MPEP § 2143.03. An obviousness inquiry requires looking at a number of factors, including the background knowledge possessed by a person having ordinary skill in the art, to determine whether there was an apparent reason to combine the elements of the prior art in the fashion claimed by the present invention. *KSR Int'l v. Teleflex, Inc.*, No. 04-1350, slip op. at 14 (U.S., Apr. 30, 2007). For the Patent Office to combine references in an obviousness rejection, the Patent Office must identify a reason why a person of ordinary skill in the art would have combined the references. *Id.* at 15. If the Patent Office cannot establish obviousness, the claims are allowable.

First, Pitroda is maybe the least pertinent reference used in a rejection in the prosecution of this case. Appellant fails to see why the Patent Office is using the Pitroda reference. It teaches almost none of the elements of the claimed invention. The Patent Office admits as much by bringing in all of the secondary references. Pitroda is directed to a universal electronic transaction card ("UET card") that is capable of serving as a number of different credit cards, bank cards, ID cards, employee cards, medical and health care management cards, and the like (Pitroda, Abstract). The UET card includes storage elements, an input interface, a processor, a display, and a communications interface. In one embodiment, transactional and account information may be transferred between the UET card and a personal or mainframe computer. *Ibid.*

Claim 1 recites a portable device comprising:

- a) a body;
- b) memory within the body containing software and financial account information;
- c) an interface associated with the memory and adapted to facilitate interaction with the host computing device during a computing session;
- d) the software adapted to execute on the host computing device to instruct the host computing device to:
  - i) recognize financial account fields in a web page during a browsing session;
  - ii) fill in the financial account fields in the web page with the financial account information from the portable device to facilitate a web-based transaction;
  - iii) automatically execute on the host computing device in association with the computing session; and
  - iv) in association with termination of the computing session, instruct the host computing device to remove records pertaining to the computing session from the host computing device to enhance privacy associated with the computing session.

Pitroda, either alone or in combination with the other references, fails to teach at least the following elements of claim 1 in combination:

- 1) software within the body of the portable device that is adapted to execute on the host computing device to instruct the host computing device;
- 2) the software adapted to execute on the host computing device to instruct the host computing device to recognize and fill in financial account fields in a web page with financial account information from the portable device;
- 3) the software adapted to automatically execute on the host computing device in association with the computing session; and
- 4) the software adapted to execute on the host computing device to instruct the host computing device to remove records pertaining to the computing session from the host computing device upon termination of the computing session.

**1. The Combination of Pitroda, Arnold, and Turgeon, and Further in View of Official Notice, Does Not Teach or Suggest Software Within the Body of the Portable Device that is Adapted to Execute on the Host Computing Device to Instruct the Host Computing Device**

The Patent Office asserts that Pitroda, col. 10, lines 40-50, and Figure 4 teaches software adapted to execute on the host computing device to instruct the host computing device (Final Office Action mailed March 8, 2007, p. 3). Appellant respectfully disagrees. Column 10, lines 40-50 of Pitroda merely discloses that a home PC may interact with the UET card to perform transactional analysis needed for tax review, summary, or budgeting purposes. Pitroda discloses software for interfacing between the home PC and the UET card for reading information from the card, but it does not indicate that this software is resident on the UET card. Thus, this software is not software within the body of the portable device that is adapted to execute on the host, as required by the claimed invention. In the Final Office Action, the Patent Office attempts to refute Appellant's argument by citing to col. 11, lines 58-67 (Final Office Action mailed March 8, 2007, p. 14). The cited portion of Pitroda discloses only that there are software blocks which may be used in the UET card. The software blocks may include a database that includes a unique number assigned to the UET card, a primary credit card issuing company or service institution number, personal data, and the like (Pitroda, col. 11, lines 58-67). This software that may be on the UET card in Pitroda is not software adapted to execute on the host computing device to instruct the host computing device, as recited in the claimed invention. It is merely data. In addition, the software referred to as being on the UET card in Pitroda at col. 11, lines 58-67 is not the same software that is discussed at col. 19, lines 40-50 for interfacing between the home PC and the UET card for reading information from the card. Thus, Pitroda does not teach software **within the body of the portable device** that is adapted to execute on the host computing device to instruct the host computing device.

Moreover, the software disclosed at col. 10, lines 40-50 of Pitroda is just for reading information from the card; there is no mention of the software **instructing** the host computer to do anything, as is required by the claimed invention. Likewise, the software blocks discussed at col. 11, lines 48-57 of Pitroda are merely a database for personal data and ID numbers and do not include software for **instructing** the host computer to do anything. The Patent Office also gives a new reference to col. 12, lines 33-36 of Pitroda (Final Office Action mailed March 8, 2007, p. 14). This passage merely indicates that the UET card software includes modules for I/O drivers,

display drivers, utility and command management, clock and calendar, initialization, and authorization/security. There is no mention that this software instructs the host to do anything. In fact, it seems as though this software is for managing and operating the UET card (see Pitroda, col. 12, lines 37-44), and not instructing the host device. Thus, Pitroda fails to teach or suggest software adapted to execute on the host computing device to instruct the host computing device, as required by the claimed invention. Therefore, Pitroda fails to teach the limitation for which it is cited.

The Patent Office also asserts that Appellant appears to argue that the software that provides functionality resides exclusively on the portable device and that this feature is not recited in the claims (Final Office Action mailed March 8, 2007, p. 14). Appellant disagrees. This is exactly what the claims do recite. Claim 1 recites a portable device having a body and a memory within the body that contains software and financial account information. This software on the portable device is adapted to execute on the host computing device to instruct the host device to:

- i) recognize financial account fields in a web page during a browsing session;
- ii) fill in the financial account fields in the web page with the financial account information from the portable device to facilitate a web-based transaction;
- iii) automatically execute on the host computing device in association with the computing session; and
- iv) in association with termination of the computing session, instruct the host computing device to remove records pertaining to the computing session from the host computing device to enhance privacy associated with the computing session.

The Patent Office's assertion that the claim language merely implies that a signal is provided from the portable device to execute software that is present on the host is simply incorrect and not consistent with the plain language of the claims. The claims clearly recite that the software **on the portable device** is adapted to execute on the host computing device to instruct the host computing device to carry out the steps listed in the claims.

**2. The Combination of Pitroda, Arnold, and Turgeon, and Further in View of Official Notice, Does Not Teach or Suggest Software Adapted to Execute on the Host Computing Device to Instruct the Host Computing Device to Recognize and Fill In Financial Account Fields in a Web Page with Financial Information from the Portable Device**

The Patent Office admits that Pitroda fails to teach software adapted to execute on the host computing device to instruct the host computing device to recognize and fill in financial account fields in a web page with financial account information from the portable device (Final Office Action mailed March 8, 2007, p. 3). The Patent Office claims that Arnold discloses using an ancillary computing device to analyze web page fields and fill in the appropriate fields. *Ibid.* Appellant respectfully submits that Arnold does not teach or suggest software adapted to execute on the host computing device to instruct the host computing device to recognize and fill in financial account fields in a web page with financial account information from the portable device. In Arnold, there is a site map database that contains information which maps the fields of a personal information database to frames of a Web page. A robot program at a data center where the databases are located correlates the personal information fields with the frames of the Web page and sends the personal information to a palmtop computer. The palmtop computer uses the information to automatically populate the frames of a Web clipping that represents a Web page (Arnold, col. 1, lines 47-61; see also Figure 6). The Web clipping is not the same as a Web page (*Id.* at col. 6, lines 13-64).

The robot program in Arnold that correlates the personal information fields with the frames of the Web page is located in data center 320 (Arnold, Figure 6; see also col. 6, line 65 through col. 7, line 12). Thus, the software of Arnold is not software that executes on the host computing device, as required by the claimed invention. In addition, the robot program of Arnold does not instruct the host computing device to recognize and fill in financial account fields in a web page. In Arnold, the robot program in the data center, not the host computing device, populates the fields of the Web clipping (*Id.* at col. 8, lines 26-35). Finally, Arnold does not teach or suggest software adapted to execute on the host computing device to instruct the host computing device to recognize and fill in financial account fields in a web page with financial account information from the portable device. In Arnold, the personal information comes from personal information database 350 in data center 320 (*Id.* at Figure 6; see also col. 7, lines 13-17; and col. 8, lines 30-32). The personal information is stored in the personal



information database 350 because it is considered undesirable to store confidential information within the palmtop computer (*Id.* at col. 7, lines 13-21). Thus, Arnold does not disclose filling in the financial account fields with financial account information from a portable device since the personal information in Arnold is stored in a secure database. In fact, if anything, Arnold teaches away from the claimed invention, since it teaches that it is undesirable to store personal information on a portable device. MPEP § 2141.02. Based on the above, it is clear that Arnold does not teach the element for which it is cited.

In the Final Office Action, the Patent Office seemingly argued that the robot program of Arnold was not the relevant disclosure, but rather the software resident on the portable device that places the information that is retrieved by the robot into the form on the laptop (Final Office Action mailed March 8, 2007, p. 15). First of all, a prior art reference must be considered in its entirety, including disclosures which teach away from the claims. MPEP §2141.02, citing *W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 721 F.2d 1540 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984). The Patent Office cannot just excise the portions that it believes are favorable to its position and ignore those portions which conflict with its position. Moreover, Appellant finds no teaching in Arnold that the portable device contains software that instructs the host computing device to recognize and fill in financial account fields in a web page with financial account information from the portable device. Appellant respectfully submits that the Patent Office is confusing where the various software resides in the cited references. In any event, Arnold does not teach or suggest software adapted to execute on the host computing device to instruct the host computing device to recognize and fill in financial account fields in a web page with financial account information from the portable device. As discussed above, the software of Arnold is not software that executes **on the host computing device**, as required by the claimed invention. In addition, Arnold does not teach or suggest software on a portable device that **instructs the host computing device** to recognize and fill in financial account fields in a web page. In Arnold, the robot program in the data center, not the host computing device, populates the fields of the Web clipping (*Id.* at col. 8, lines 26-35). Finally, Arnold does not teach or suggest software adapted to execute on the host computing device to instruct the host computing device to recognize and fill in financial account fields in a web page with financial account information **from the portable device**.

**3. The Combination of Pitroda, Arnold, and Turgeon, and Further in View of Official Notice, Does Not Teach or Suggest Software Adapted to Automatically Execute on the Host Computing Device in Association with the Computing Session**

The Patent Office also admits that Pitroda does not teach that the software is adapted to automatically execute on the host computing device in association with the computing session (Final Office Action mailed March 8, 2007, p. 4). However, the Examiner asserts that auto run capability is old and well known in the art as shown in Appellant's Specification at page 6, line 30 through page 7, line 15. Then the Examiner takes Official Notice that automatically executing a remote device on a host device is old and well known in the art (Final Office Action mailed March 8, 2007, p. 4). The Examiner then states that it would have been obvious to include in Pitroda an auto-execute program because it "will simplify the accessing of the remote application by not requiring the devices application to be manually loaded when it is clear that the user wishes to use the device when it is inserted into the host device." *Ibid*.

To establish *prima facie* obviousness, the Patent Office must show where each and every element of the claim is taught or suggested in the combination of references. MPEP § 2143.03. An obviousness inquiry requires looking at a number of factors, including the background knowledge possessed by a person having ordinary skill in the art, to determine whether there was an apparent reason to combine the elements of the prior art in the fashion claimed by the present invention. *KSR Int'l v. Teleflex, Inc.*, No. 04-1350, slip op. at 14 (U.S., Apr. 30, 2007). For the Patent Office to combine references in an obviousness rejection, the Patent Office must identify a reason why a person of ordinary skill in the art would have combined the references. *Id.* at 15. If the Patent Office cannot establish obviousness, the claims are allowable.

Appellant respectfully submits that the Patent Office has failed to identify an apparent reason why a person of ordinary skill in the art would modify Pitroda to include the auto-run feature alleged to be old and well-known in the art. In this case, the Patent Office has failed to provide any reason why one of ordinary skill in the art would combine Pitroda with what is alleged to be well-known in the art. Since the Patent Office has failed to carry its burden, the combination is improper. Since the combination is improper, the rejection should be withdrawn.

Moreover, as discussed above, Pitroda does not teach software adapted to execute on the host computing device to instruct the host computing device, as required by the claimed invention. Pitroda merely discloses a UET card that has information on it. There is no software

on the UET card that executes on a host computing device to instruct the host to perform the steps of the claimed invention. Thus, there is no need for Pitroda to include an autorun feature. In fact, Appellant respectfully submits that adding an autorun feature to Pitroda would not work since there is no software on the UET card that could execute on a host device to instruct the host device to do anything. In addition, trying to add something like an auto-run feature to Pitroda would impermissibly change the principle of operation of Pitroda or render Pitroda unsatisfactory for its intended purpose. MPEP § 2143.01. For the above reasons, it would not be obvious to modify Pitroda to add an auto-run feature.

**4. The Combination of Pitroda, Arnold, and Turgeon, and Further in View of Official Notice, Does Not Teach or Suggest Software Adapted to Execute on the Host Computing Device to Instruct the Host Computing Device in Association with the Termination of the Computing Session to Remove Records Pertaining to the Computing Session from the Host Computing Device**

Pitroda also does not teach or suggest “in association with termination of the computing session, instruct the host computing device to remove records pertaining to the computing session from the host computing device to enhance privacy associated with the computing session.” The Patent Office admits that Pitroda does not teach this element, but asserts that Figure 5, step 521 of Turgeon shows the recited element (Final Office Action mailed March 8, 2007, p. 4). Turgeon does disclose that during the Web transaction, after the information is retrieved from the CD, and the information and the PIN are transferred to the merchant payment module at the Web host server, a memory in the PC is flushed to erase data used by the active Web module, which expires on the PC (Turgeon, paragraph 0052). However, the flushing of the memory in Turgeon is not equivalent to the removal of records pertaining to the computing session from the host computing device to enhance privacy associated with the computing session. Moreover, in Turgeon, it is not the **software provided by the portable device** that instructs the host computing device to remove records pertaining to the computing device, as required by the claimed invention.

Additionally, the flushing of the memory in Turgeon is not done “in association with termination of the computing session.” Instead, in Turgeon, after the flushing of the memory is done, the Web host server continues the transaction (Turgeon, paragraph 0053; see also steps Figures 5b-5d, 522-570). The Patent Office responds and points to item 514, which the Patent

Office alleges ends the interactive session with the portable device and initiates the request for an e-pin and transfer to the web server (Final Office Action mailed March 8, 2007, p. 16). This further proves Appellant's position. Item 514 is only a determination of whether the e-commerce debit card was removed from the CD-ROM drive. The session continues through steps 522-570 of Figures 5b-5d. Thus, Turgeon does not teach software adapted to "in association with termination of the computing session, instruct the host computing device to remove records pertaining to the computing session from the host computing device to enhance privacy associated with the computing session." Therefore, claim 1 is patentable for this additional reason.

Moreover, Appellant respectfully submits that the Patent Office has failed to provide a proper motivation to combine Turgeon with Pitroda, Arnold, and the auto-run feature alleged to be old and well-known in the art. The Patent Office alleges that the stated motivation to combine Turgeon with Pitroda is to "improve the security of sensitive data by not allowing the data to reside on a device that is not secure." (Final Office Action mailed March 8, 2007, p. 4). However, the Patent Office has failed to provide an apparent reason why one of ordinary skill in the art would combine Turgeon with Pitroda, Arnold, and the auto-run feature alleged to be old and well-known in the art. Since the Patent Office has failed to meet its burden of identifying an apparent reason why a person of ordinary skill in the art would combine the references with the allegedly well known feature, the combination is improper. Since the combination is improper, the rejection should be withdrawn.

In addition, the stated motivation does not compel the combination. First, the UET card already includes security features to prevent unauthorized use (Pitroda, Abstract). Thus, Pitroda does not need to improve the security of data. Accordingly, the stated motivation does not apply to Pitroda. Since the stated motivation is inapplicable to Pitroda, the motivation is improper. Since the motivation is improper, the combination is improper, and the rejection should be withdrawn for this additional reason.

Finally, Pitroda discloses that a home PC may interact with the UET card to perform transactional analysis needed for tax review, summary, or budgeting purposes. Pitroda discloses software for interfacing between the home PC and the UET card for reading information from the card (Pitroda, col. 10, lines 40-50). Thus, in order for Pitroda to perform transactional analysis for tax review, summary, or budgeting purposes, the PC would need the information for

some period of time. Thus, flushing the PC to remove data would render Pitroda unsuitable for its intended purpose. MPEP § 2143.01. Therefore, the combination is improper for this further reason.

In summary, the Patent Office has failed to properly support an apparent reason why one of ordinary skill in the art would combine the various references with the requisite actual evidence. Instead, the Patent Office is improperly attempting to pick and choose the elements of the invention from various pieces of prior art and then using hindsight to combine them. *In re Fine*, 837 F.2d 1071, 1074 (Fed. Cir. 1988) (“One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.”). Thus, the combinations are improper. Even if the combinations were proper, a point Appellant does not concede, none of the cited references, either alone or in combination, teach or suggest a portable device that has software on the portable device that is adapted to automatically execute on a host computing device in association with a computing session, where the software is adapted to execute on the host and instruct the host to recognize financial account fields in a web page during a browsing session, fill in the financial account fields in the web page with the financial account information from the portable device to facilitate a web-based transaction, and in association with termination of the computing session, instruct the host computing device to remove records pertaining to the computing session from the host computing device to enhance privacy associated with the computing session. Thus, the claims of the present invention are allowable.

Claim 1 was used in the analysis above. However, claims 13 and 21 contain similar limitations and are patentable for at least the same reasons. Claims 2-7 and 9-12 depend from claim 1 and contain all of the limitations of claim 1. Claims 14-19 depend from claim 13 and contain all of the limitations of claim 13. Claims 22-27 depend from claim 21 and contain all of the limitations of claim 21. Thus, claims 2-7, 9-12, 14-19, and 22-27 are also patentable.

**E. Claims 1-7, 9-19, and 21-27 Are Patentable Over Davis in View of Arnold and Turgeon and Further in View of Official Notice**

Claims 1-7, 9-19, and 21-27 were also rejected under 35 U.S.C. § 103(a) as being unpatentable over Davis in view of Arnold and Turgeon and further in view of Official Notice.

Appellant previously discussed the fact that Davis lacked several elements of the claimed invention as set forth in claim 1, including in an interview between Appellant's representative Rick Witcher and Examiner Mark Fadok on September 26, 2006, in which the Davis reference was proffered as an anticipatory reference. In the interview, Appellant's representative focused on the lack of teaching in Davis of software on the portable device that is adapted to automatically execute on the host computing device in association with the computing session because that seemed to be the easiest argument to understand. The Examiner at that time was unable to point to anything in Davis that showed the software automatically executing on the host. Appellant's representative also pointed out that Davis failed to teach that the software was adapted to execute on the host computing device to instruct the host to perform the claimed steps. In addition, Appellant's representative pointed out that Davis was prior art only if Davis could claim priority to one of the provisional applications and queried whether the provisionals to which Davis claim priority adequately supported the disclosure of recognizing and filling in the financial account fields in the web page with the financial account information from the portable device. The Examiner indicated that he had reviewed the provisional and believed it contained all of the features of the instant claims, but did not point to any specific portion of the provisional(s) that showed the recognizing and filling in of the financial account fields. Finally, Appellant's representative pointed out that Davis did not teach the software on the portable device adapted to execute on the host and instruct the host computing device to remove records pertaining to the computing session from the host computing device in association with termination of the computing session. In the Final Office Action mailed March 8, 2007, the Patent Office now admits that Davis lacked certain elements of the claimed invention, but asserts that a combination of Davis, Arnold, Turgeon, and Official Notice discloses the claimed invention. This position is indicative of the changing position of the Patent Office in this case, in light of the Appellant's pointing out the deficiencies of the cited references.

**1. The Combination of Davis, Arnold, Turgeon, and Official Notice Does Not Teach or Suggest Software Within the Body of the Portable Device that is Adapted to Execute on the Host Computing Device to Instruct the Host Computing Device**

In the Final Office Action, the Patent Office admits that Davis does not teach several elements of the claimed invention. The Patent Office does state that paragraph 0036 of Davis

discloses software on a portable device that is adapted to execute on the host computing device to instruct the host computing device (Final Office Action mailed March 8, 2007, p. 8).

Appellant respectfully disagrees. Davis discloses a smart card device 410 that is configured with the functionality of a server to provide for operation and control of multiple applications (Davis, paragraph 0036). The smart card device can be configured through an interface with the access device 430. As a result, the smart card device can organize, manage, and store information locally in a portable device. However, there is no indication in Davis that the applications on the smart card device are adapted to execute **on the host computing device to instruct the host computing device**, as required by the claimed invention. The applications on the smart card act locally and do not execute on the host to instruct the host to perform the steps of the claimed invention.

The Patent Office also asserts that paragraph 0043 of Davis teaches processing applications from the smart card on a client device. Appellant respectfully disagrees. Paragraph 0043 of Davis discloses that the smart card device may provide user data to data management component 450 of the access device 430. User data is not software. The smart card device of Davis merely provides data to the access device; it does not contain software adapted to execute on the host computing device to instruct the host computing device. Similarly, in paragraph 0059, Davis discloses that a user financial application 604 on the smart card device can be used to import financial information to another web site or vendor. However, there is no teaching or suggestion that the user financial application 604 is executed on the access device to instruct the access device to import the financial device. Accordingly, Davis fails to teach or suggest software on a portable device that is adapted to execute on the host computing device to instruct the host computing device to perform the claimed steps. Thus, Davis does not even teach the element for which it is cited. Therefore, the combination fails to teach or suggest each and every element of the claimed invention, and the claims are allowable.

**2. The Combination of Davis, Arnold, Turgeon, and Official Notice Does Not Teach or Suggest Software Adapted to Execute on the Host Computing Device to Instruct the Host Computing Device to Recognize and Fill In Financial Account Fields in a Web Page with Financial Information from the Portable Device**

The Patent Office now admits that Davis does not disclose software adapted to execute on the host computing device to instruct the host computing device to recognize and fill in financial account fields in a web page with financial account information from the portable device (Final Office Action mailed March 8, 2007, p. 8). Instead, the Patent Office relies on Arnold to teach this limitation. As discussed above, Arnold does not teach or suggest software adapted to execute on the host computing device to instruct the host computing device to recognize and fill in financial account fields in a web page with financial account information from the portable device.

In Arnold, there is a site map database that contains information which maps the fields of a personal information database to frames of a Web page. A robot program at a data center where the databases are located correlates the personal information fields with the frames of the Web page and sends the personal information to a palmtop computer. The palmtop computer uses the information to automatically populate the frames of a Web clipping that represents a Web page (Arnold, col. 1, lines 47-61; see also Figure 6). The robot program in Arnold that correlates the personal information fields with the frames of the Web page is located in data center 320 (*Id.* at Figure 6; see also col. 6, line 65 through col. 7, line 12). Thus, the software of Arnold is not software that executes **on the host computing device**, as required by the claimed invention. In addition, the robot program of Arnold does not **instruct the host computing device** to recognize and fill in financial account fields in a web page. In Arnold, the robot program in the data center, not the host computing device, populates the fields of the Web clipping (*Id.* at col. 8, lines 26-35). Finally, Arnold does not teach or suggest software adapted to execute on the host computing device to instruct the host computing device to recognize and fill in financial account fields in a web page with financial account information **from the portable device**. In Arnold, the personal information comes from personal information database 350 in data center 320 (*Id.* at Figure 6; see also col. 7, lines 13-17; and col. 8, lines 30-32). The personal information is stored in the personal information database 350 because it is considered undesirable to store confidential information within the palmtop computer (*Id.* at col. 7, lines 13-



21). Thus, Arnold does not disclose filling in the financial account fields with financial account information from a portable device since the personal information in Arnold is stored in a secure database. In fact, if anything, Arnold teaches away from the claimed invention, since Arnold teaches that it is undesirable to store personal information on a portable device. MPEP § 2141.02. Based on the above, it is clear that Arnold does not teach the element for which it is cited.

**3. The Combination of Davis, Arnold, Turgeon, and Official Notice Does Not Teach or Suggest Software Adapted to Automatically Execute on the Host Computing Device in Association with the Computing Session**

The Patent Office also admits that Davis does not teach that the software is adapted to automatically execute on the host computing device in association with the computing session (Final Office Action mailed March 8, 2007, p. 9). However, the Examiner asserts that auto run capability is old and well known in the art as shown in Appellant's Specification at page 6, line 30 through page 7, line 15. Then the Examiner takes Official Notice that automatically executing a remote device on a host device is old and well known in the art (Final Office Action mailed March 8, 2007, p. 9). The Examiner additionally states that it would have obvious to include an auto-execute program in Davis because it "will simplify the accessing of the remote application by not requiring the device to be manually loaded when it is clear that the user wishes to use the device when it is inserted into the host device." *Ibid*.

Appellant notes that this is the same motivation given to modify Pitroda. Appellant believes this indicates that the Patent Office is not providing the requisite actual evidence to support the motivation to modify the reference. In any event, Appellant submits that the Patent Office has failed to provide a proper motivation to modify Davis to include the auto-run feature alleged to be old and well-known in the art for similar reasons set forth above with respect to Pitroda. The Patent Office has failed to provide any actual evidence to support the stated motivation to combine Davis with what is alleged to be well-known in the art. Since the stated motivation lacks the requisite actual evidence in support, the motivation is improper. Since the motivation is improper, the combination is improper, and the rejection should be withdrawn.

Moreover, similar to the discussion above with respect to Pitroda, Davis does not teach software on the portable device that is adapted to execute on the host computing device to instruct the host computing device, as required by the claimed invention. Davis discloses a smart

card device that has information and applications on it. There is no software on the smart card device that executes on a host computing device to instruct the host to perform the steps of the claimed invention. Thus, there is no need for Davis to include an autorun feature. In fact, Appellant respectfully submits that adding an autorun feature to Davis would not work since there is no software on the smart card device that executes on a host device to instruct the host device to do anything. In addition, trying to add something like an auto-run feature to Davis would impermissibly change the principle of operation of Davis or render Davis unsatisfactory for its intended purpose. MPEP § 2143.01. For the above reasons, it would not be obvious to modify Davis to add an auto-run feature.

**4. The Combination of Davis, Arnold, Turgeon, and Official Notice Does Not Teach or Suggest Software Adapted to Execute on the Host Computing Device to Instruct the Host Computing Device in Association with the Termination of the Computing Session to Remove Records Pertaining to the Computing Session from the Host Computing Device**

The Patent Office admits that Davis also does not teach or suggest the element “in association with termination of the computing session, instruct the host computing device to remove records pertaining to the computing session from the host computing device to enhance privacy associated with the computing session.” (Final Office Action mailed March 8, 2007, p. 9). Instead, the Patent Office asserts this limitation is shown by Figure 5, step 521 of Turgeon. *Ibid.* As discussed previously, Turgeon does disclose that during the Web transaction, after the information is retrieved from the CD, and the information and the PIN are transferred to the merchant payment module at the Web host server, a memory in the PC is flushed to erase data used by the active Web module, which expires on the PC (Turgeon, paragraph 0052). However, the flushing of the memory in Turgeon is not equivalent to the removal of records pertaining to the computing session from the host computing device to enhance privacy associated with the computing session. Moreover, in Turgeon, it is not the software on the portable device that instructs the host computing device to remove records pertaining to the computing device, as required by the claimed invention. Finally, the flushing of the memory in Turgeon is not done “in association with termination of the computing session.” Instead, in Turgeon, after the flushing of the memory is done, the Web host server continues the transaction (*Ibid.*; see also Figures 5b-5d, steps 522-570). Thus, Turgeon does not teach software adapted to “in association

with termination of the computing session, instruct the host computing device to remove records pertaining to the computing session from the host computing device to enhance privacy associated with the computing session.” Therefore, claim 1 is patentable for this additional reason.

Moreover, Appellant respectfully submits that the Patent Office has failed to provide an apparent reason why a person of ordinary skill in the art would combine Turgeon with Davis, Arnold, and the auto-run feature alleged to be old and well-known in the art. The Patent Office alleges that the stated motivation to combine Turgeon with Davis is to “improve the security of sensitive data by not allowing the data to reside on a device that is not secure or will be usable by another at a latter time.” (Office Action mailed October 19, 2006, p. 9). Appellant notes that this is the same motivation given to modify Pitroda. Appellant believes this indicates that the Patent Office is not providing the requisite apparent reason to modify the reference. In any event, Appellant submits that the Patent Office has failed to provide an apparent reason to modify Davis to include the auto-run feature alleged to be old and well-known in the art for similar reasons set forth above with respect to Pitroda. In particular, the Patent Office has failed to provide any actual evidence to support why one of ordinary skill in the art would combine Turgeon with Davis, Arnold, and the auto-run feature alleged to be old and well-known in the art. Since the Patent Office has failed to provide an apparent reason for the combination, the combination is improper. Since the combination is improper, the rejection should be withdrawn.

In addition, the stated motivation does not compel the combination. First, the smart card device of Davis can already be configured to facilitate secured transactions (Davis, paragraphs 0066-0068). Thus, Davis does not need to improve the security of data. Accordingly, the stated motivation does not apply to Davis. Since the stated motivation is inapplicable to Davis, the motivation is improper. Since the motivation is improper, the combination is improper, and the rejection should be withdrawn for this additional reason.

In summary, the Patent Office has failed to properly support an apparent reason why one of ordinary skill in the art would combine the various references with the requisite actual evidence. Instead, the Patent Office is improperly attempting to pick and choose the elements of the invention from various pieces of prior art and then use hindsight to combine them. *In re Fine*, 837 F.2d 1071, 1074 (Fed. Cir. 1988) (“One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.”).

Thus, the combinations are improper. Even if the combinations were proper, a point Appellant does not concede, none of the cited references, either alone or in combination, teach or suggest a portable device that has software on the portable device that is adapted to automatically execute on a host computing device in association with a computing session, where the software is adapted to execute on the host and instruct the host to recognize financial account fields in a web page during a browsing session, fill in the financial account fields in the web page with the financial account information from the portable device to facilitate a web-based transaction, and in association with termination of the computing session, instruct the host computing device to remove records pertaining to the computing session from the host computing device to enhance privacy associated with the computing session. Thus, the claims of the present invention are allowable.

Claim 1 was used in the analysis above. However, claims 13 and 21 contain similar limitations and are patentable for at least the same reasons. Claims 2-7 and 9-12 depend from claim 1 and contain all of the limitations of claim 1. Claims 14-19 depend from claim 13 and contain all of the limitations of claim 13. Claims 22-27 depend from claim 21 and contain all of the limitations of claim 21. Thus, claims 2-7, 9-12, 14-19, and 22-27 are also patentable.

**F. Claims 4, 5, 16, 17, 24, and 25 Are Patentable Over Pitroda in View of Turgeon and Inala and Further in View of Official Notice**

The Patent Office asserts that claims 4, 5, 16, 17, 24, and 25 are unpatentable over Pitroda in view of Turgeon and Inala, and further in view of Official Notice (Final Office Action mailed March 8, 2007, pp. 6-7). With respect to claims 4, 16, and 24, the Patent Office admits that Pitroda does not teach or suggest “wherein the portable device stores login information for a web site associated with the web-based transaction and the software is further adapted to instruct the host computing device to determine if login information is necessary for the web site and provide the login information upon entering the web site,” but asserts that Inala discloses this feature (Final Office Action mailed March 8, 2007, p. 7).

First, Appellant respectfully submits that the Patent Office has failed to provide a proper motivation to combine Inala with Pitroda and the other cited art. The Patent Office alleges that the stated motivation to combine Inala is “because this would save the user time and provide a (sic) automatic and transparent access to restricted websites to the user.” (Final Office Action

mailed March 8, 2007, p. 7). However, the Patent Office has failed to provide an apparent reason why one of ordinary skill in the art would combine Inala with Pitroda and the other cited references. Instead, the Patent Office just makes a conclusory statement without any support. Thus, the alleged combination is improper. Since the combination is improper, the rejection should be withdrawn.

Even if adding Inala to the combination were proper, a point Appellant does not concede, the combination still does not teach each and every element of the claimed invention. Claims 4, 16, and 24 depend from claims 1, 13, and 21, respectively, and add the additional limitation of “wherein the portable device stores login information for a web site associated with the web-based transaction and the software is further adapted to instruct the host computing device to determine if login information is necessary for the web site and provide the login information upon entering the web site.” As set forth above, the combination of Pitroda, Arnold, Turgeon, and what was asserted to be old and well-known in the art still does not teach or suggest each and every element of claim 1. Inala does not cure the deficiencies of the other references in this regard. Thus, claims 4, 16, and 24 are patentable based on their dependency on claims 1, 13, and 21, respectively.

In addition, Inala merely discloses an auto-login feature. This is not equivalent to the claimed “wherein the portable device stores login information for a web site associated with the web-based transaction and the software is further adapted to instruct the host computing device to determine if login information is necessary for the web site and provide the login information upon entering the web site.” Further, the login information in Inala is not stored in a portable device. The Patent Office admits that Inala’s login information is not on a portable device, but that Pitroda’s UET card is capable of storing different software programs and could therefore include the software for loading the form that is resident in the PC of Inala (Final Office Action mailed March 8, 2007, p. 19). First, the mere fact that references can be combined does not render the resultant combination obvious. MPEP § 2143.01. Such a combination or modification of the references to attempt to reach the claimed invention is more than a routine matter. The Patent Office fails to explain how the UET card of Pitroda would successfully incorporate the auto login feature without using Appellant’s Specification as a blueprint. And even if the auto log-in feature were somehow incorporated into the UET card of Pitroda, the combination still would not teach or suggest software on a portable device that “is further

adapted to instruct the host computing device to determine if login information is necessary for the web site and provide the login information upon entering the web site,” as required by claims 4, 16, and 24. Thus, the combination does not teach each and every element of claims 4, 16, and 24, and claims 4, 16, and 24 are patentable for this additional reason.

Likewise, claims 5, 17, and 25 add the further limitation of “wherein a bookmark for the web site is stored on the portable device and the software is further adapted to instruct the host computing device to make the bookmark accessible by a browser running on the host computing device such that a user may use the bookmark to efficiently access the web site via the browser.” The Patent Office asserts that the combination of Pitroda and Inala teaches the bookmark limitation (Final Office Action mailed March 8, 2007, p. 7). Appellant has reviewed Pitroda and finds no mention of a bookmark being stored on the UET card. Inala does disclose a Password-All Portal and software that can be used to manage a user’s bookmarks (Inala, col. 8, lines 25-41). However, the bookmarks mentioned in Inala are not stored on a portable device, as recited by the claimed invention. The Patent Office admits that Inala’s code for establishing bookmarks is not on the portable device, but that Pitroda’s UET card is capable of storing different software programs and could therefore include the software for loading the form that is resident in the PC of Inala (Final Office Action mailed March 8, 2007, p. 19). First, the mere fact that references can be combined does not render the resultant combination obvious. MPEP § 2143.01. Such a combination or modification of the references to attempt to reach the claimed invention is more than a routine matter. The Patent Office fails to explain how the UET card of Pitroda would successfully incorporate the bookmark limitation without using Appellant’s Specification as a blueprint.

In addition, neither Pitroda nor Inala, either alone or in combination, teach or suggest software on the portable device that is further adapted “to instruct the host computing device to make the bookmark accessible by a browser running on the host computing device such that a user may use the bookmark to efficiently access the web site via the browser,” as required by claims 5, 17, and 25. Thus, the combination does not teach each and every element of claims 5, 17, and 25, and claims 5, 17, and 25 are patentable for this additional reason.

## G. Conclusion

The Patent Office has not shown where all the elements of the claims are shown with sufficient particularity to sustain an obviousness rejection. None of the cited references, either alone or in combination, teach or suggest the following elements in combination:

- 1) software within the body of the portable device that is adapted to execute on the host computing device to instruct the host computing device;
- 2) the software adapted to execute on the host computing device to instruct the host computing device to recognize and fill in financial account fields in a web page with financial account information from the portable device;
- 3) the software adapted to automatically execute on the host computing device in association with the computing session; and
- 4) the software adapted to execute on the host computing device to instruct the host computing device to remove records pertaining to the computing session from the host computing device upon termination of the computing session.

Since the Patent Office has not made a *prima facie* case of showing where each and every element of the claimed invention is taught or suggested by the references, the claimed invention is patentable.

Moreover, the Patent Office has failed to provide an apparent reason why one of ordinary skill in the art would combine the references in the manner asserted by the Patent Office.

For the foregoing reasons, Appellant requests that the Board reverse the Examiner and instruct the Examiner to allow the claims for these reasons.

Respectfully submitted,

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Date: July 18, 2007

Attorney Docket: 4989-005

## **(8) CLAIMS APPENDIX**

1. A portable device comprising:
  - a) a body;
  - b) memory within the body containing software and financial account information;
  - c) an interface associated with the memory and adapted to facilitate interaction with the host computing device during a computing session;
  - d) the software adapted to execute on the host computing device to instruct the host computing device to:
    - i) recognize financial account fields in a web page during a browsing session;
    - ii) fill in the financial account fields in the web page with the financial account information from the portable device to facilitate a web-based transaction;
    - iii) automatically execute on the host computing device in association with the computing session; and
    - iv) in association with termination of the computing session, instruct the host computing device to remove records pertaining to the computing session from the host computing device to enhance privacy associated with the computing session.
2. The portable device of claim 1 wherein the financial account information relates to a plurality of financial accounts, the software further adapted to instruct the host computing device to:
  - a) query a user to select one of the plurality of financial accounts;
  - b) receive selected indicia from the user; and
  - c) fill in the financial account fields in the web page with certain of the financial account information corresponding to the selected one of the plurality of financial accounts.
3. The portable device of claim 1 wherein the software is further adapted to provide an authentication routine to execute on the host computing device, the authentication routine instructing the host computing device to receive authentication indicia from a user via an interface on the host computing device and determine if the authentication indicia received from the user matches authentication indicia stored on the portable device.



4. The portable device of claim 1 wherein the portable device stores login information for a web site associated with the web-based transaction and the software is further adapted to instruct the host computing device to determine if login information is necessary for the web site and provide the login information upon entering the web site.
5. The portable device of claim 1 wherein a bookmark for the web site is stored on the portable device and the software is further adapted to instruct the host computing device to make the bookmark accessible by a browser running on the host computing device such that a user may use the bookmark to efficiently access the web site via the browser.
6. The portable device of claim 1 wherein the portable device stores shipping information for a item selected for purchase during the web-based transaction and the software is further adapted to instruct the host computing device to access the shipping information and provide the shipping information to the web site to facilitate delivery of the item selected for purchase.
7. The portable device of claim 1 wherein the shipping information includes a plurality of shipping addresses, the software further adapted to instruct the host computing device to:
  - a) query a user to select one of the plurality of shipping addresses;
  - b) receive selection indicia from the user; and
  - c) fill in the shipping address fields with certain of the shipping information corresponding to the selected one of the plurality of shipping addresses.
8. (Cancelled).
9. The portable device of claim 1 wherein the software is adapted to emulate a file system resident on the host computing device when interacting with the host computing device.
10. The portable device of claim 1 wherein the software is adapted to appear as a file system to the host computing device.

11. The portable device of claim 1 wherein the interface is adapted to directly interface a port in the host computing device.

12. The portable device of claim 1 wherein the interface is adapted to provide a wireless interface with the host computing device.

13. A computer readable medium including software to reside on a portable device capable of interacting with a plurality of host computing devices, the software comprising instructions for the host computing device to:

execute on the host computing device during a computing session;

recognize financial account fields in a web page during a browsing session; and

fill in the financial account fields in the web page with financial account information stored on the portable device to facilitate a web-based transaction,

said software further adapted to execute automatically on the host computing device in association with the computing session, and

in association with termination of the computing session, instruct the host computing device to remove records pertaining to the computing session from the host computing device to enhance privacy associated with the computing session.

14. The computer readable medium of claim 13 wherein the financial account information relates to a plurality of financial accounts, the software further adapted to instruct the host computing device to:

a) query a user to select one of the plurality of financial accounts;

b) receive selection indicia from the user; and

c) fill in the financial account fields in the web page with certain of the financial account information corresponding to the selected one of the plurality of financial accounts.

15. The computer readable medium of claim 13 wherein the software is further adapted to provide an authentication routine to execute on the host computing device, the authentication routine instructing the host computing device to receive authentication indicia from a user via an

interface on the host computing device and determine if the authentication indicia received from the user matches authentication indicia stored on the portable device.

16. The computer readable medium of claim 13 wherein the portable device stores login information for a web site associated with the web-based transaction and the software is further adapted to instruct the host computing device to determine if login information is necessary for the web site and provide the login information upon entering the web site.

17. The computer readable medium of claim 13 wherein a bookmark for the web site is stored on the portable device and the software is further adapted to instruct the host computing device to make the bookmark accessible by a browser running on the host computing device such that the user may use the bookmark to efficiently access the web site via the browser.

18. The computer readable medium of claim 13 wherein the portable device stores shipping information for an item selected for purchase during the web-based transaction and the software is further adapted to instruct the host computing device to access the shipping information and provide the shipping information to the web site to facilitate delivery of the item selected for purchase.

19. The computer readable medium of claim 13 wherein the shipping information includes a plurality of shipping addresses, the software further adapted to instruct the host computing device to:

- a) query a user to select one of the plurality of shipping addresses;
- b) receive selection indicia from the user; and
- c) fill in the shipping address fields with certain of the shipping information corresponding to the selected one of the plurality of shipping addresses.

20. (Cancelled).

21. A method for facilitating a web-based transaction using a portable device capable of interacting with a plurality of host computing devices, the method comprising:

executing software resident on the portable device on a host computing device in association with a computing session, the software adapted to instruct the host computing device:

recognize financial account fields in a web page during a browsing session;

fill in the financial account fields in the web page with financial account information stored on the portable device to facilitate a web-based transaction, wherein the software is further adapted to execute automatically on the host computing device in association with the computing session; and

remove records pertaining to the computing session from the host computing device to enhance privacy associated with the computing session in association with termination of the computing session.

22. The method of claim 21 wherein the financial account information relates to a plurality of financial accounts, the method further comprising:

- a) querying the user to select one of the plurality of financial accounts;
- b) receiving selection indicia from the user; and
- c) filling in the financial account fields in the web page with certain of the financial account information corresponding to the selected one of the plurality of financial accounts.

23. The method of claim 21 further receiving authentication indicia from a user via an interface on the host computing device and determining if the authentication indicia received from the user matches authentication indicia stored on the portable device.

24. The method of claim 21 wherein the portable device stores login information for a web site associated with the web-based transaction and further comprising determining if login information is necessary for the web site and providing the login information upon entering the website.

25. The method of claim 21 wherein a bookmark for the website is stored on the portable device and further comprising making the bookmark accessible by a browser running on the host computing device such that a user may use the bookmark to efficiently access the web site via the browser.

26. The method of claim 21 wherein the portable device stores shipping information for an item selected for purchase during the web-based transaction and further comprising accessing the shipping information and providing the shipping information to the web site to facilitate delivery of the item selected for purchase.

27. The method of claim 21 wherein the shipping information includes a plurality of shipping addresses and further comprising:

- a) querying a user to select one of the plurality of shipping addresses;
- b) receiving selection indicia from the user; and
- c) filling in the shipping address fields with certain of the shipping information corresponding to the selected one of the plurality of shipping addresses.

28. (Cancelled).

**(9) EVIDENCE APPENDIX**

The Appellants rely on no evidence, thus this appendix is not applicable.

**(10) RELATED PROCEEDINGS APPENDIX**

This appeal is related to an appeal brief filed for the above-referenced application on January 3, 2005 and a revised appeal brief filed on October 12, 2005 (attached in Appendix A).

# **Appendix A**



**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Application of: Shimon S. Shmueli

Serial No. 09/802,634

Filed: 03/09/2001

For: **ACCOUNT PORTABILITY FOR COMPUTING**

Examiner: Fadok, Mark A.

Art Unit: 3625

Mail Stop Appeal Brief - Patents

Commissioner for Patents

PO Box 1450

Alexandria, VA 22313-1450

Sir:

The present **REVISED APPEAL BRIEF** is filed pursuant to 37 C.F.R. § 47.37(c). Appellant has previously paid for the Appeal Brief, so no new fee should be required. If any additional fees are required in association with this appeal brief, the Director is hereby authorized to charge them to Deposit Account 50-1732, and consider this a petition therefor.

**REVISED APPEAL BRIEF**

**(1) REAL PARTY IN INTEREST**

The real party in interest is M-Systems Flash Disk Pioneers of Kfar Saba, Israel.

**(2) RELATED APPEALS AND INTERFERENCES**

There are no related appeals or interferences to the best of Appellant's knowledge.

**(3) STATUS OF CLAIMS**

Claims 1-7, 9-19, and 21-27 are pending and stand rejected, with the rejection made final on August 26, 2004.

Claims 1-7, 9-19, and 21-27 are the subject of the current appeal.

**(4) STATUS OF AMENDMENTS**

Appellant filed non-substantive amendments on October 5, 2004. The Advisory Action of October 21, 2004 indicates that these amendments were not entered. Appellant proceeds with the appeal with the claims as they were presented prior to the amendments of October 5, 2004.

## **(5) SUMMARY OF CLAIMED SUBJECT MATTER**

The present invention is designed to simplify a user's interaction with a computing device, and is particularly designed to facilitate use of web sites visited by the computing device during the course of a computing session. Specifically, the user carries a portable memory device (10A), such as a card (10B), that has computer readable memory (18) associated therewith. The portable memory device has an appropriate interface (24) through which it may communicate with the computing device (12) during the computing session. The memory contains computer readable software (20) that automatically executes on the computing device (12) during the computing session (page 6, lines 3-25; page 6, line 33-page 7, line 3). In particular, the automatically executing software determines that the user is using a web browser and has visited a web site that has a web page having financial account fields thereon. The software on the portable device automatically fills in the financial account fields to facilitate the completion of a web-based transaction (step 122, Figure 3B and page 21, line 21-page 22, line 31). In an exemplary embodiment, credit card information and shipping information may be filled in by the automatically executing software of the present invention.

To further assist the user, the software of the present invention also removes the financial information from the various memories of the computing device (step 130, Figure 3B and page 11, line 26-page 12, line 11). For example, cookies are deleted, caches are cleared, and other temporary memory buffers are purged so that a subsequent user of the computing device can not retrieve private information about the previous user.

Claim 1 defines a portable device (such as 10A), that has a body (such as the body of the card 10B), with memory (18) within the body. The memory has software (20) and data stored therein. The device also has an interface (24) so that the portable device may communicate with the computing device (12). The software (20) is adapted to execute on the computing device (12) so that the computing device (12) recognizes financial account fields on web pages during browsing sessions. Upon recognition of the financial account fields, the software (20) uses the data in the memory (18) to populate the financial account fields. The software (20) is also adapted to execute automatically on the computing device (12) (step 122, Figure 3B and page 21, line 21-page 22, line 31). Furthermore, the software (20) is adapted to perform the clean up function described above (step 130, Figure 3B and page 11, line 26-page 12, line 11).

Claim 13 is similar to claim 1, albeit as a computer readable medium with software having instructions to perform the same steps as recited in claim 1. That is, the software executes on the computing device, recognizes account fields on web pages during browsing sessions, fills in the fields with data from the memory, and performs the clean up function.

Claim 21 is likewise similar to claim 1, albeit as a pure method claim. The method includes executing software on the computing device, recognizing account fields on web pages during browsing sessions, filling in the fields with data from the memory, and performing the clean up function.

#### **(6) GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL**

Whether claims 14 and 19 contain objectionable material.

Whether claims 1, 3-6, 9-13, 15-18, 21, and 23-26 are unpatentable under 35 U.S.C. § 103 over O'Leary et al., in view of Rallis et al., in further view of de la Huerga.

Whether claims 2, 7, 14, 19, 22, and 27 are unpatentable under 35 U.S.C. § 103 over O'Leary et al., in view of Rallis et al., in view of de la Huerga, and further in view of Official Notice.

#### **(7) ARGUMENT**

##### **A. Introduction**

The combination of references of record does not teach or suggest that financial account information is stored in a portable device for use with a host computing device, as recited in the claims. Since the Patent Office has not shown where the combination of references teaches or suggests all the claim elements, the Patent Office has not established *prima facie* obviousness. Since the Patent Office has not established obviousness, Appellant requests that the Board reverse the Examiner and instruct the Examiner to allow the application.

##### **B. Standard for Obviousness**

###### **1. The Statute**

Section 103(a) of the Patent Act provides the statutory basis for an obviousness rejection and reads as follows:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

## **2. The Interpretation**

To establish *prima facie* obviousness, the Patent Office must show that each and every element of the claim is taught by the prior art. *In re Royka*, 490 F.2d 981 (C.C.P.A. 1974); MPEP § 2143.03. There are essentially three basic ways that an obviousness rejection can be formulated. The first basic way in which a claim can be rejected under 35 U.S.C. § 103 is through a modified reference. That is, while the reference does not disclose every element of the claim as required under 35 U.S.C. § 102, there is a suggestion to modify the reference to include the missing claim element such that the modified reference teaches each of the claim elements. The second basic way in which a claim can be rejected under 35 U.S.C. § 103 is through a combination of references. That is, there is a suggestion to combine two or more references to show all the claim elements. The third way in which a claim can be rejected under 35 U.S.C. § 103 is through a combination of references, one of which is modified to show a missing claim element. That is, there is an initial suggestion to combine a number of references to teach the majority of the claim elements, and there is a second suggestion to modify this combination of references to include the missing claim element.

It is well recognized that almost every invention is a combination of elements from the prior art. *Ryko Mfg. Co. v. Nu-Star, Inc.*, 950 F.2d 714, 718 (Fed. Cir. 1991). One of the things that make an invention patentable is that it would not have been obvious to one of ordinary skill in the art to combine references, modify a reference, or modify a combination of references to arrive at the claimed invention.

The Federal Circuit prohibits the Patent Office from using hindsight reconstruction to arrive at the claimed invention when making an obviousness rejection. *In re Gorman*, 933 F.2d 892 (Fed. Cir. 1991). To help combat the possibility of such hindsight reconstruction, the Federal Circuit established several rules. The Patent Office must comply with these rules when making an obviousness rejection. Initially, the references may not be gathered with the claimed invention in mind. *Pentec, Inc. v. Allen*, 776 F.2d 309, 313 (Fed. Cir. 1985). Furthermore, the

Federal Circuit cautions that “one cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.” *In re Fine*, 837 F.2d 1071, 1075 (Fed. Cir. 1988). To reconstruct the invention by the selective extraction from the prior art constitutes impermissible hindsight. *In re Gorman*. A reference must be considered for all that it teaches. *In re Fritch*, 972 F.2d 1260, 1264 (Fed. Cir. 1992). The Federal Circuit has indicated that the Patent Office cannot remove elements from a reference, or take single elements out of the reference. *Id.* at 1266.

As yet another “defense against the subtle but powerful attraction of a hindsight-based obviousness analysis”, the Federal Circuit has stated that when the Patent Office proposes a combination of references, the Patent Office must do two things. First, the Patent Office must articulate a motivation to combine the references, and second, the Patent Office must provide actual evidence in support of the articulated motivation. *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999); *see also In re Lee*, 277 F.3d 1338, 1343-44 (Fed. Cir. 2002). The Federal Circuit acknowledged that there are myriad sources of support, including the references, the knowledge of one of ordinary skill in the art, and the nature of the problem to be solved. “The range of sources available, **does not diminish the requirement for actual evidence.**” *In re Dembiczak* at 999 (emphasis added).

The year after *Dembiczak*, the Federal Circuit followed *Dembiczak* by applying the actual evidence requirement to modifications of single references. Specifically, to modify a single reference the Patent Office must articulate a motivation to modify the reference and then further support such motivation to modify by providing actual evidence. *In re Kotzab*, 217 F.3d 1365, 1370 (Fed. Cir. 2000).

This is not a new standard, because as early as 1992, the Federal Circuit had applied a similar rule to a modified combination. The Federal Circuit held that, even after combination, the combination may not be modified absent an additional showing of a suggestion of the desirability of the modification. *In re Fritch* at 1266 (citing *In re Gordon*, 733 F.2d 900, 902 (Fed. Cir. 1984)).

Thus, the Patent Office has several different mechanisms through which it can construct an obviousness rejection, but there are certain rules that the Patent Office must follow while using these mechanisms. Regardless of the nature of the mechanism used, the Patent Office must still teach or suggest all of the claim elements. If a claim element is lacking, then the

Patent Office has not established *prima facie* obviousness. “If the PTO fails to meet this burden, then the Appellant is entitled to the patent.” *In re Glaug*, 283 F.3d 1335, 1338 (Fed. Cir. 2002).

### **C. Summary of the References**

#### **1. O’Leary et al., U.S. Patent 6,609,113**

O’Leary et al. (hereinafter “O’Leary”) describes a system that allows for electronic fund transference to effectuate electronic commerce. In particular, the system pushes payments to the payee rather than the payee making a draw against payor’s accounts. In this fashion, the account information of the payor may be kept confidential such that the risk of the account information being compromised is minimized. To accomplish this, O’Leary describes a “digital Wallet” 215 that has a Payment Portal Processor (PPP) which has two addresses associated therewith. The first address is associated with an Internet Pay Anyone (IPA) that sends credits across the Electronic Funds Transfer (EFT) Network. This first address is a private address. The second address is an address at which pushed credits are received from the EFT. This second address only receives credits, and thus may be published without fear of compromising any secure account information. The user funds the PPP with money, such as from a credit card, and the IPA draws thereagainst when the IPA sends credits out through the EFT.

Important to the system disclosed by O’Leary is that the Wallet 215 is downloaded and installed from a website. However, using “thin wallet technology, the majority of software and databases comprising the Wallet 215 resides on a host web server and the user accesses the Wallet 215 through a website or button (e.g., icon) on the Browser 210.” *O’Leary*, column 9, lines 9-15. The Wallet 215, which is primarily on the web server, stores form filling information such as credit card numbers, debit card numbers, shipping addresses, and the like. *O’Leary*, column 9, line 66-column 10, line 13. Using this stored information, the Wallet 215 automatically fills in electronic merchant purchase forms. *O’Leary*, column 10, lines 15-16.

#### **2. Rallis et al., U.S. Patent 6,425,084**

Rallis et al. (hereinafter “Rallis”) describes a system for providing security for a laptop computer. Specifically, a portable “key” 20 is used at power-up to enable operation. The key holds an encrypted unique serial number, which is selectively used in conjunction with a personal identification number (PIN). At start up, the computer accesses the key 20 to secure authorization to use the computer.

### **3. de la Huerga, U.S. Patent 5,960,085**

de la Huerga describes a security badge that allows selective access to information on a computer. Specifically, the security badge allows a user to login to a computer through an authentication routine. The computer continuously or periodically interrogates the security badge to ascertain whether the security badge is still present. When the security badge is removed from the range of the interrogator, the screen is blanked or the keyboard locked. An extended absence results in the user being logged off automatically. *de la Huerga*, column 4, line 59-column 5, line 10.

After the user is logged off, the system deletes and/or overwrites any files that have been cached on the computer terminal. In particular, the cache associated with the Internet browser may be purged. *de la Huerga*, column 45, lines 11-26.

#### **D. Argument**

##### **1. For claims 1, 3-6, 9-13, 15-18, 21, and 23-26, the Combination Does Not Show a Claim Element**

The Patent Office states that the combination of O'Leary, Rallis, and de la Huerga teaches or suggests all the claim elements. To the contrary, the combination proposed by the Patent Office does not teach or suggest that the financial account information is stored on the portable device as recited in the claims. While each of the claims recites this element, Appellant chooses claim 21 of the application as illustrative. Specifically, claim 21 recites "filling in the financial account fields in the web page with financial account information stored on the portable device to facilitate a web-based transaction. . . ."

When the references are combined, the system that is taught by the combination is a portable device (from de la Huerga or Rallis), such as a security badge (from de la Huerga), that stores an authentication key that allows the computer to be accessed and used (from de la Huerga or Rallis). Once the computer is accessed, the user may log in to the digital Wallet on a server through a web browser (from O'Leary). When the user reaches a web site that has financial or shipping forms to be filled, the digital Wallet secures information from the web server associated with the digital Wallet and fills in the fields on the web page (from O'Leary). The system derived from the combination of elements is not the same as Appellant's claimed invention, which requires that the financial account information be stored on the portable device. Since the combination does not show the claim element, the Patent Office has not established *prima facie*

obviousness. Since the Patent Office has not established obviousness, Appellant requests that the Board reverse the Examiner and instruct the Examiner to allow the claims.

In the Patent Office's analysis of the references and the claims, the Patent Office has not shown the claim element. The Patent Office opines that *O'Leary*, column 4, lines 55-65 and column 5, lines 15-20 teaches "memory within the body containing software and financial account information." *O'Leary*, column 4, lines 55-65 states in full:

The structural components to the system of the present invention include: a Payment Portal Processor; a digital Wallet; an Internet Pay Anyone (IPA) Account; a Virtual Private Lockbox (VPL); an Account Reporter; the existing EFT networks; and a cash card. The Payment Portal Processor (PPP) is a software application that augments any Internet browser with e-commerce capability. The PPP software sits in front of and provides a secure portal for accessing (linking to) the user's Demand Deposit Accounts (DDA) and IPA accounts. The PPP enables the user to push electronic credits from its DDA and IPA accounts to any other accounts through the EFT network.

Likewise, *O'Leary*, column 5, lines 15-20 states in full: "The majority of the prior art electronic Wallets on the Internet today are primarily used as a convenience vehicle, merely providing a method of storing account number information and other form filling functions (e.g., shipping addresses)."

While the cited passages do describe the PPP, IPA, and digital Wallet of *O'Leary*, there is no indication that the financial information is actually stored in the personal digital assistant (PDA) of *O'Leary*. In fact, as noted above in the summary of *O'Leary*, *O'Leary* highlights the "thin wallet" nature of the digital Wallet, and indicates that the financial information is not on the PDA, but rather is on the web server remotely positioned from the PDA. See, for example, *O'Leary*, column 9, lines 9-15. Appellant acknowledges that *O'Leary* teaches a wallet that stores financial information, but this wallet does not store financial information on the PDA or "body" of the portable device, as recited in the claims. *O'Leary* clearly teaches the wallet on the server, and the Patent Office's reading of *O'Leary* amounts to an impermissible extraction of an isolated element that ignores *O'Leary*'s teachings with regards to the thin nature of the wallet.

Appellant raised this point in the Response filed October 5, 2004. The Patent Office's response is short and does not illuminate on what basis the Patent Office is ignoring the thin wallet teachings of *O'Leary*. Specifically, the Advisory Action of October 21, 2004 states "Applicant's arguments were not persuasive in overcoming the previous rejection." Such a



broad allegation is insufficient to explain how the combination of references shows this element, since O'Leary clearly does not teach or suggest that the financial information is stored on the portable device.

Appellant has proven that O'Leary does not teach or suggest the recited claim element, and the Patent Office has pointed to no other portion of the other references where such an element is taught or suggested. Since the references individually do not teach or suggest the claim element, the combination cannot teach or suggest the claim element, and the Patent Office has not established obviousness. Since the Patent Office has not established obviousness, Appellant requests that the Board reverse the Examiner and instruct the Examiner to allow the claims.

Appellant further addresses a permutation of the above position. Specifically, the Patent Office may opine that it would be obvious to modify O'Leary to include the financial information on the portable device. As noted above, if the Patent Office wishes to modify a combination, the Patent Office must explain from where the motivation for such a modification comes. *In re Fritch*. Recent case law further indicates that when advancing motivations to modify references or combine references, the Patent Office must present actual evidence to support such motivations. *In re Kotzab*; *In re Dembiczak*. To date, the Patent Office has not provided any motivation to modify the combination such that the financial information is stored on the portable device. The Patent Office has not provided any actual evidence to support the motivation to modify the combination either, such that the financial information is stored on the portable device. Since the Patent Office has not justified the modification to the combination, and the combination does not establish obviousness, Appellant requests that the Board reverse the Examiner and instruct the Examiner to allow the claims.

## **2. For Claims 2, 7, 14, 19, 22, and 27, the Combination Does Not Show a Claim Element**

As explained above, the combination of O'Leary, Rallis, and de la Huerga do not establish obviousness for the independent claims. The addition of the subject matter on which the Patent Office asserts Official Notice does not cure the deficiencies of the underlying combination. Thus, the greater combination of O'Leary, Rallis, de la Huerga, and Official Notice does not establish obviousness.

Appellant requests withdrawal of the § 103 rejection of claims 2, 7, 14, 19, 22, and 27 for these reasons.

### **3. Claims 14 and 19 Are Not Objectionable**

Claims 14 and 19 were objected to because of alleged informalities. Specifically, the Patent Office opines that the dependent claims use reference characters “a” through “c”, but that the underlying independent claims had such reference characters deleted by way of the previous amendment. Appellant notes that the uses of reference characters in the various claims are independent of one another. That is, the use of the reference characters “a”, “b”, and “c” in claim 14 is not a reference to the elements previously labeled “a”, “b”, or “c” in claim 13 (from which claim 14 depends). The elements denoted by reference characters “a”, “b”, and “c” in claim 14 are software instructions for the host computing device, as is clearly indicated in the preamble of the claim. Since the reference characters of claim 14 do not refer to the deleted reference characters of claim 13, there is no ambiguity raised by the use of such reference characters in claim 14. Therefore, the use of the reference characters in claim 14 is not objectionable. The same arguments are true for claim 19, which also depends from claim 13.

Since the use of the reference characters is not objectionable, Appellant requests that the Board instruct the Examiner to withdraw the objection to claims 14 and 19 on this issue. Alternatively, Appellant requests the opportunity to delete the reference characters as Appellant attempted to do in the amendments filed on October 5, 2004, but which were not entered.

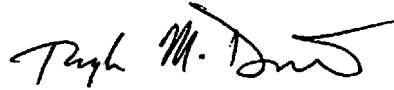
### **E. Conclusion**

The Patent Office has not shown where in the prior art financial information is stored on the portable device as recited in the claims. Since the Patent Office has not shown this claim element, the Patent Office has not established *prima facie* obviousness. Since the Patent Office has not established obviousness, the claims are allowable. Appellant requests that the Board reverse the Examiner and instruct the Examiner to allow the claims.

Respectfully submitted,

WITHROW & TERRANOVA, P.L.L.C.

By:



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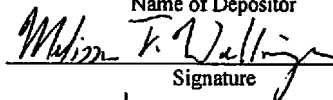
Date: October 12, 2005  
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## **(8) APPENDIX**

### **1. A portable device comprising:**

- a) a body;**
- b) memory within the body containing software and financial account information;**
- c) an interface associated with the memory and adapted to facilitate interaction with the host computing device during a computing session;**
- d) the software adapted to execute on the host computing device to instruct the host computing device to:**
  - i) recognize financial account fields in a web page during a browsing session;**
  - ii) fill in the financial account fields in the web page with the financial account information from the portable device to facilitate a web-based transaction;**
  - iii) automatically execute on the host computing device in association with the computing session; and**
  - iv) in association with termination of the computing session, instruct the host computing device to remove records pertaining to the computing session from the host computing device to enhance privacy associated with the computing session.**

### **2. The portable device of claim 1 wherein the financial account information relates to a plurality of financial accounts, the software further adapted to instruct the host computing device to:**

- a) query a user to select one of the plurality of financial accounts;**
- b) receive selected indicia from the user; and**
- c) fill in the financial account fields in the web page with certain of the financial account information corresponding to the selected one of the plurality of financial accounts.**

3. The portable device of claim 1 wherein the software is further adapted to provide an authentication routine to execute on the host computing device, the authentication routine instructing the host computing device to receive authentication indicia from a user via an interface on the host computing device and determine if the authentication indicia received from the user matches authentication indicia stored on the portable device.

4. The portable device of claim 1 wherein the portable device stores login information for a web site associated with the web-based transaction and the software is further adapted to instruct the host computing device to determine if login information is necessary for the web site and provide the login information upon entering the web site.

5. The portable device of claim 1 wherein a bookmark for the web site is stored on the portable device and the software is further adapted to instruct the host computing device to make the bookmark accessible by a browser running on the host computing device such that a user may use the bookmark to efficiently access the web site via the browser.

6. The portable device of claim 1 wherein the portable device stores shipping information for a item selected for purchase during the web-based transaction and the software is further adapted to instruct the host computing device to access the shipping information and provide the shipping information to the web site to facilitate delivery of the item selected for purchase.

7. The portable device of claim 1 wherein the shipping information includes a plurality of shipping addresses, the software further adapted to instruct the host computing device to:

- a) query a user to select one of the plurality of shipping addresses;
- b) receive selection indicia from the user; and
- c) fill in the shipping address fields with certain of the shipping information corresponding to the selected one of the plurality of shipping addresses.

9. The portable device of claim 1 wherein the software is adapted to emulate a file system resident on the host computing device when interacting with the host computing device.
10. The portable device of claim 1 wherein the software is adapted to appear as a file system to the host computing device.
11. The portable device of claim 1 wherein the interface is adapted to directly interface a port in the host computing device.
12. The portable device of claim 1 wherein the interface is adapted to provide a wireless interface with the host computing device.
13. A computer readable medium including software to reside on a portable device capable of interacting with a plurality of host computing devices, the software comprising instructions for the host computing device to:
- execute on the host computing device during a computing session;
  - recognize financial account fields in a web page during a browsing session; and
  - fill in the financial account fields in the web page with financial account information stored on the portable device to facilitate a web-based transaction,
- said software further adapted to execute automatically on the host computing device in association with the computing session, and
- in association with termination of the computing session, instruct the host computing device to remove records pertaining to the computing session from the host computing device to enhance privacy associated with the computing session.

14. The computer readable medium of claim 13 wherein the financial account information relates to a plurality of financial accounts, the software further adapted to instruct the host computing device to:

- a) query a user to select one of the plurality of financial accounts;
- b) receive selection indicia from the user; and
- c) fill in the financial account fields in the web page with certain of the financial account information corresponding to the selected one of the plurality of financial accounts.

15. The computer readable medium of claim 13 wherein the software is further adapted to provide an authentication routine to execute on the host computing device, the authentication routine instructing the host computing device to receive authentication indicia from a user via an interface on the host computing device and determine if the authentication indicia received from the user matches authentication indicia stored on the portable device.

16. The computer readable medium of claim 13 wherein the portable device stores login information for a web site associated with the web-based transaction and the software is further adapted to instruct the host computing device to determine if login information is necessary for the web site and provide the login information upon entering the web site.

17. The computer readable medium of claim 13 wherein a bookmark for the web site is stored on the portable device and the software is further adapted to instruct the host computing device to make the bookmark accessible by a browser running on the host computing device such that the user may use the bookmark to efficiently access the web site via the browser.

18. The computer readable medium of claim 13 wherein the portable device stores shipping information for an item selected for purchase during the web-based transaction and the software is further adapted to instruct the host computing device to access the shipping information and

provide the shipping information to the web site to facilitate delivery of the item selected for purchase.

19. The computer readable medium of claim 13 wherein the shipping information includes a plurality of shipping addresses, the software further adapted to instruct the host computing device to:

- a) query a user to select one of the plurality of shipping addresses;
- b) receive selection indicia from the user; and
- c) fill in the shipping address fields with certain of the shipping information corresponding to the selected one of the plurality of shipping addresses.

21. A method for facilitating a web-based transaction using a portable device capable of interacting with a plurality of host computing devices, the method comprising:

- a) executing software resident on the portable device on a host computing device in association with a computing session:
- b) recognizing financial account fields in a web page during a browsing session;
- c) filling in the financial account fields in the web page with financial account information stored on the portable device to facilitate a web-based transaction; and
- d) remove records pertaining to the computing session from the host computing device to enhance privacy associated with the computing session in association with termination of the computing session.

22. The method of claim 21 wherein the financial account information relates to a plurality of financial accounts, the method further comprising:

- a) querying the user to select one of the plurality of financial accounts;
- b) receiving selection indicia from the user; and



c) filling in the financial account fields in the web page with certain of the financial account information corresponding to the selected one of the plurality of financial accounts.

23. The method of claim 21 further receiving authentication indicia from a user via an interface on the host computing device and determining if the authentication indicia received from the user matches authentication indicia stored on the portable device.

24. The method of claim 21 wherein the portable device stores login information for a web site associated with the web-based transaction and further comprising determining if login information is necessary for the web site and providing the login information upon entering the website.

25. The method of claim 21 wherein a bookmark for the website is stored on the portable device and further comprising making the bookmark accessible by a browser running on the host computing device such that a user may use the bookmark to efficiently access the web site via the browser.

26. The method of claim 21 wherein the portable device stores shipping information for an item selected for purchase during the web-based transaction and further comprising accessing the shipping information and providing the shipping information to the web site to facilitate delivery of the item selected for purchase.

27. The method of claim 21 wherein the shipping information includes a plurality of shipping addresses and further comprising:

- a) querying a user to select one of the plurality of shipping addresses;
- b) receiving selection indicia from the user; and

c) filling in the shipping address fields with certain of the shipping information corresponding to the selected one of the plurality of shipping addresses.

**(9) EVIDENCE APPENDIX**

Appellant does not rely on any evidence submitted pursuant to 37 C.F.R. §§ 1.130, 1.131, or 1.132, and thus, this Appendix is not applicable.

**(10) RELATED PROCEEDINGS APPENDIX**

As stated above, there are no related proceedings, so this appendix is not applicable.



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/802,634	03/09/2001	Shimon Shmueli	4989-005	8535

27820 7590 11/17/2005

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EXAMINER

FADOK, MARK A

ART UNIT PAPER NUMBER

3625

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**GROUP 3600**

**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 09/802,634  
Filing Date: March 09, 2001  
Appellant(s): SHMUELI ET AL.

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Benjamin S. Withrow  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed January 5, 2005.

**(1) Real Party in Interest**

A statement identifying the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

A statement identifying the related appeals and interferences, which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

**(3) Status of Claims**

The statement of the status of the claims contained in the brief is correct.

**(4) Status of Amendments After Final**

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

The amendment after final rejection filed on 10/5/2004 has not been entered.

**(5) Summary of Invention**

The summary of invention contained in the brief is correct.

**(6) Issues**

The appellant's statement of the issues in the brief is correct.

**(7) Claims Appealed**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(8) Prior Art of Record**

6,609,113	O'Leary et al.	8-2003
6,425,084	Rallis et al.	7-2002
5,960,085	de la Huerga	9-1999

**(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-7,9-19, and 21-27 rejected under 35 U.S.C. 103. This rejection is set forth in a prior Office Action, mailed on 8/26/2004 and is reproduced below.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 1,3-6,9-13,15-18,21 and 23-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over O'Leary et al. (US 6,609,113) in view of Rallis et al. (US 6,425,084).**

**In regards to claim 1, O'Leary discloses a portable device comprising: a) a body (col 5, lines 55-60, PDA and cell phone technologies, note: applicant's invention PG pub**



Art Unit: 3625

2002/0147653, page 3, para 31, indicates that the key can be implemented on a PDA or mobile phone);

b) memory within the body containing software and financial account information (col 4, lines 55-65, col 5, lines 15-20, and col 9, lines 15-20);

O'Leary teaches interacting with a smart card (col 1, line 36), which is known to carry personal information that can be transferred to a host device and loading software to a processor, (see Payment Portal Processor (PPP)). This software program augments any Internet browser with e-commerce capability. O'Leary, however, does not specifically mention that the device has an interface that facilitates interaction with the computing device. Rallis teaches a key that is inserted into a host computer containing memory. It would have been obvious to a person having ordinary skill in the art to include in O'Leary the key device of Rallis, because this would allow personal information and computing software to be transported to accessing devices, creating improved security and accessibility (see Rallis col 1, protection of data in smart cards and the needed improvement to protect the device from use).

d) the software adapted to execute on the host computing device to instruct the host computing device to:

- i) recognize financial account fields in a web page during a browsing session (col 5, lines 15-40); and
- ii) fill in the financial account fields in the web page with the financial account information from the portable device to facilitate a web-based transaction (col 5, lines 29-35, payment forms automatically filled out).

automatically execute on the host computing device in association with the computing session (col 9, lines 9-30); and

The combination of O'Leary and Rallis teach protecting user information and transferring information from a device to a host, but does not specifically mention the removal of records pertaining to the computing session from the host computing device to enhance privacy associated with the computing session. De la Huerga teaches instructions for overwriting and deletion of any memory cache or temporary workspace used by the user after log off (FIG 15E). It would have been obvious to one having ordinary skill in the art at the time of the invention to include in the combination of O'Leary/Rallis the removal of records pertaining to the computing session from the host computing device to enhance privacy associated with the computing session as taught by de la Huerga, because this would provide increased security from hackers trying to attain personal information that was cached on the computing device (de la Huerga, col 5, lines 10-25).

**In regards to claim 3**, O'Leary teaches wherein the software is further adapted to provide an authentication routine to execute on the host computing device (col 5, lines 50-67),

O'Leary teaches authenticating using indicia (col 17, lines 1-10), but does not specifically mention that the indicia is from a portable unit. Rallis teaches authenticating a user by way of a portable key that stores encrypted identifying indicia which is validated with stored matching information on a second device (see abstract and FIG 1).

Art Unit: 3625

It would have been obvious to a person having ordinary skill in the art at the time of the invention to include in O'Leary storing indicia on a portable device for authentication, because by having portability, the item could be used as a sophisticated key and improve the usefulness of the system of O'Leary by not requiring the user to remember complex algorithms.

**In regards to claim 4**, O'Leary teaches wherein the portable device stores login information for a web site associated with the web-based transaction (col 9, lines 11-30) and

the software is further adapted to instruct the host computing device to determine if login information is necessary for the web site and provide the login information upon entering the web site (col 14, lines 20-30).

**In regards to claim 5**, O'Leary teaches wherein a bookmark for the web site is stored on the portable device and

the software is further adapted to instruct the host computing device to make the bookmark accessible by a browser running on the host computing device such that a user may use the bookmark to efficiently access the web site via the browser (col 9, lines 1-30, website button link).

**In regards to claim 6**, O'Leary teaches wherein the portable device stores shipping information for an item selected for purchase during the web-based transaction and

the software is further adapted to instruct the host computing device to access the shipping information and provide the shipping information to the web site to facilitate delivery of the item selected for purchase (col 9, line 62 through col 10, line 12).

**In regards to claim 9**, O'Leary teaches wherein the software is adapted to emulate a file system resident on the host computing device when interacting with the host computing device. (col 5, lines 15-40, saved wallet data)

**In regards to claim 10**, O'Leary teaches wherein the software is adapted to appear as a file system to the host computing device (FIG 6, Item 215, wallet).

**In regards to claim 11**, O'Leary teaches wherein the interface is adapted to directly interface a port in the host computing device (Rallis, FIG 1A and 1B).

**In regards to claim 12**, O'Leary teaches wherein the interface is adapted to provide a wireless interface with the host computing device (col 5, lines 55-60, cell phones and PDA's).

**In regards to claim 13**, O'Leary discloses a computer readable medium including software to reside on a portable device capable of interacting with a plurality of host computing devices,

the software comprising instructions for the host computing device to:

Art Unit: 3625

a) execute on the host computing device during a computing session;

b) recognize financial account fields in a web page during a browsing session; and

c) fill in the financial account fields in the web page with financial account information stored on the portable device to facilitate a web-based transaction.

said software further adapted to execute automatically execute on the host computing device in association with the computing session; and

in association with termination of the computing session, instruct the host computing device to remove records pertaining to the computing session from the host computing device to enhance privacy associated with the computing session (see response to claim 1).

**In regards to claim 15,** O'Leary teaches wherein the software is further adapted to provide an authentication routine to execute on the host computing device,

the authentication routine instructing the host computing device to receive authentication indicia from a user via an interface on the host computing device and determine if the authentication indicia received from the user matches authentication indicia stored on the portable device (see response to claim 3).

**In regards to claim 16,** O'Leary teaches wherein the portable device stores login information for a web site associated with the web-based transaction and the software is further adapted to instruct the host computing device to determine if login information is necessary for the web site and provide the login information upon entering the web site (see response to claim 4).

**In regards to claim 17,** O'Leary teaches wherein a bookmark for the web site is stored on the portable device and the software is further adapted to instruct the host computing device to make the bookmark accessible by a browser running on the host computing device such that the user may use the bookmark to efficiently access the web site via the browser (see response to claim 5).

**In regards to claim 18,** O'Leary teaches wherein the portable device stores shipping information for an item selected for purchase during the web-based transaction and the software is further adapted to instruct the host computing device to access the shipping information and provide the shipping information to the web site to facilitate delivery of the item selected for purchase (see response to claim 6).

**In regards to claim 21,** O'Leary discloses a method for facilitating a web-based transaction using a portable device capable of interacting with a plurality of host computing devices, the method comprising: a) executing software resident on the portable device on a host computing device in association with a computing session; b)

Art Unit: 3625

recognizing financial account fields in a web page during a browsing session; and c) filling in the financial account fields in the web page with financial account information stored on the portable device to facilitate a web-based transaction and remove records pertaining to the computing session from the host computing device to enhance privacy associated with the computing session in association with termination of the computing session (see response to claim 1).

**In regards to claim 23**, O'Leary teaches receiving authentication indicia from a user via an interface on the host computing device and determining if the authentication indicia received from the user matches authentication indicia stored on the portable device (see response to claim 3).

**In regards to claim 24**, O'Leary teaches wherein the portable device stores login information for a web site associated with the web-based transaction and further comprising determining if login information is necessary for the web site and providing the login information upon entering the web site (see response to claim 4).

**In regards to claim 25**, O'Leary teaches wherein a bookmark for the web site is stored on the portable device and further comprising making the bookmark accessible by a browser running on the host computing device such that a user may use the bookmark to efficiently access the web site via the browser (see response to claim 5).  
26. The method of claim 21 wherein the portable device stores shipping information for an item selected for purchase during the web-based transaction and further comprising accessing the shipping information and providing the shipping information to the web site to facilitate delivery of the item selected for purchase (see response to claim 6).

**Claims 2,7,14,19,22, and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over O'Leary et al. (US 6,609,113) in view of Rallis et al. (US 6,425,084), in view of de la Huerga (5,960,085) and further in view of Official Notice.**

**In regards to claim 2**, the combination of O'Leary and Rallis teaches multiple financial accounts and debit card numbers stored on a portable device along with accessing these items (col 9, line 62 through col 10, line 12), neither, however, specifically mentions that the program queries the user for the proper entry. The use of pull down menus to offer such selections and later filling in the selected choice was old and well known in the art at the time of the invention. It would have been obvious to a person having ordinary skill in the art to include in O'Leary a presentation of choices and a selection method such as a pull down menu, because this would offer a convenient way of presenting the stored information and has been known to speed selection and save space on a web form.

Art Unit: 3625

**In regards to claim 7**, O'Leary teaches multiple shipping addresses and alternate shipping addresses stored on a portable device along with accessing these items (col 9, line 62 through col 10, line 12), but does not specifically mention that the program queries the user for the proper entry. The use of pull down menus to offer selections and later filling in the selected choice was old and well known in the art at the time of the invention. It would have been obvious to a person having ordinary skill in the art at the time of the invention to include in O'Leary a presentation of choices and selection method such as a pull down menu, because this would offer a convenient way of presenting the stored information and has been known to speed selection and save space on a web form.

**In regards to claim 14**, O'Leary teaches wherein the financial account information relates to a plurality of financial accounts, the software further adapted to instruct the host computing device to:

- a) query a user to select one of the plurality of financial accounts;
- b) receive selection indicia from the user; and
- c) fill in the financial account fields in the web page with certain of the financial account information corresponding to the selected one of the plurality of financial accounts (see response to claim 2).

**In regards to claim 19**, O'Leary teaches wherein the shipping information includes a plurality of shipping addresses,

- the software further adapted to instruct the host computing device to:
- a) query a user to select one of the plurality of shipping addresses;
  - b) receive selection indicia from the user; and
  - b) fill in the shipping address fields with certain of the shipping information corresponding to the selected one of the plurality of shipping addresses (see response to claim 7).

**In regards to claim 22**, O'Leary teaches wherein the financial account information relates to a plurality of financial accounts, the method further comprising: a) querying the user to select one of the plurality of financial accounts; b) receiving selection indicia from the user; and c) filling in the financial account fields in the web page with certain of the financial account information corresponding to the selected one of the plurality of financial accounts (see response to claim 2).

**In regards to claim 27**, O'Leary teaches wherein the shipping information includes a plurality of shipping addresses and further comprising: a) querying a user to select one of the plurality of shipping addresses; b) receiving selection indicia from the user; and c) filling in the shipping address fields with certain of the shipping information corresponding to the selected one of the plurality of shipping addresses (see response to claim 7).

***Response to Arguments***

***(10) Response to Argument***

Appellant argues that claims 14 and 19 are not objectionable, the examiner agrees with the appellant's remarks and hereby removes the Objection.

Appellant argues, in regards to claims 1,13, and 21, that the combination of O'Leary, Rallis, and de la Huerga "does not teach or suggest that the financial account information is stored on the portable device". The examiner disagrees and directs the appellant's attention to O'Leary col 9, lines 15-20, where the contents of the wallet, that includes financial information, is downloaded to a variety of portable devices such as PDA's and cellular telephones. O'Leary later fills in the form using the information from the wallet as is correctly pointed out by the appellant (page 7, second paragraph of Appeal Brief filed 1/5/2005).

For the above reasons, it is believed that the rejections should be sustained.

Application/Control Number: 09/802,634  
Art Unit: 3625

Page 10

Respectfully submitted,



Mark Fadok  
November 10, 2005

Conferees:



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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Application of: Shimon S. Shmueli et al.

Serial No. 09/802,634

Filed: 03/09/2001

For: **ACCOUNT PORTABILITY FOR COMPUTING**

Examiner: Fadok, Mark A.

Art Unit: 3625

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Sir:

The present **REPLY BRIEF** is filed to address issues raised in the Examiner's Answer mailed March 24, 2005. If any fees are required in association with this Reply Brief, the Director is hereby authorized to charge them to Deposit Account 50-1732, and consider this a petition therefor.

**REPLY BRIEF**

**Introduction**

Appellant appreciates the withdrawal of the objection to claims 14 and 19. However, the Patent Office's arguments about the teachings of O'Leary still do not teach the financial information stored on the portable device. Appellant further objects to the introduction of Turgeon advanced by the Patent Office in the Examiner's Answer. The introduction of Turgeon at this late date constitutes an impermissible shift in the Patent Office's position, needlessly cluttering the issues before the Board. Even if Turgeon is properly before the Board, the Patent Office has not established a proper motivation for its use in the rejection, and the rejection still fails to establish *prima facie* obviousness.

**Argument**

The Patent Office repeats its rejection from the Office Action of August 26, 2004. As Appellant's Appeal Brief adequately addresses the issues raised therein, Appellant focuses this Reply Brief on the Response to Arguments section raised in paragraph (11) of the Examiner's Answer.



The Patent Office initially directs attention to *O'Leary*, col. 9, lines 15-20, alleging "the contents of the wallet, that includes financial information, is downloaded to a variety of portable devices such as PDA's [sic] and cellular telephones."<sup>1</sup> However, this assertion ignores the thin wallet nature of *O'Leary* discussed at length in the Appeal Brief. In fact, the cited passage makes no indication that the portion of the Wallet downloaded to PDAs contains any financial information. In full, the passage states: "[s]ome functionality of the Wallet 215 can be operated on the workstation 200 itself, without the requirement of attachment to the Internet. In addition to PC-based access as described above, the Wallet 215 can be downloaded to various non-PC devices such as PDAs, cellular telephones, and interactive TV's [sic]."<sup>2</sup> But as previously pointed out, the immediately preceding passage indicates that the Wallet 215 is a thin wallet and the majority of the software and databases comprising the Wallet 215 resides on a host web server. *O'Leary*, col. 9, lines 10-15. Thus, when *O'Leary*, col. 9, lines 15-20 indicates that the wallet is downloaded to the PDA, this indicates that the thin wallet is downloaded to the PDA, and the majority of the software and databases remain on the web server, including the financial information. As already indicated in the Appeal Brief, the Patent Office's focus on this isolated portion of *O'Leary* constitutes an impermissible extraction of an element out of context and ignores the other relevant portions of *O'Leary*. Appellant requests that the Board reverse the Examiner and instruct the Examiner to allow the claims on this basis.

The Patent Office supplements its position by stating "Further, TURGEON is added to the previous rejection to show an example of smart card technology used for storing financial information (see claim 1)."<sup>3</sup> Appellant respectfully traverses the inclusion of Turgeon at this late date. The MPEP § 1208 states:

It also frequently happens that an examiner will state a position in the answer in a manner that represents a shift from the position stated in the final rejection without indicating that the last stated position supersedes the former. Such a situation confuses the issue and likewise poses difficulties for the Board since it is not clear exactly what the examiner's ultimate position is.<sup>4</sup>

Appellant respectfully maintains that the addition of Turgeon is a new rejection. As Turgeon was published on January 16, 2003, before the first Office Action of March 5, 2004, there is no

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<sup>1</sup> Examiner's Answer of March 24, 2005, page 9, lines 14-16.

<sup>2</sup> *O'Leary*, col. 9, lines 15-20.

<sup>3</sup> Examiner's Answer of March 24, 2005, page 9, lines 18-20 (emphasis in original).

<sup>4</sup> MPEP § 1208, p. 1200-17, August 2001 edition available at [www.uspto.gov](http://www.uspto.gov)

reason why Turgeon should not have been cited prior to the appeal if it was necessary to establish obviousness. Rather than introduce a new basis for rejection in the Examiner's Answer, the Patent Office should have re-opened prosecution and issued a new rejection based on the use of Turgeon advanced in the Examiner's Answer. Appellant notes that MPEP § 1208 also indicates that a new ground of rejection is no longer permitted in an Examiner's Answer. Since the addition of Turgeon constitutes a new ground of rejection, the use of Turgeon is improper. Appellant requests that the Board reverse the Examiner and instruct the Examiner to allow the claims on this basis.

Even if the late addition is proper, the Patent Office has not complied with the rules set forth by the Federal Circuit for combining references in an obviousness analysis. Specifically, the Patent Office has not advanced any motivation to combine the teachings of Turgeon with O'Leary, Rallis, and de la Hueraga. The Patent Office has not provided a motivation to combine the references, and the Patent Office has also not set forth actual evidence to support the motivation as required. *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999). Still further, as explained in the Appeal Brief, the Patent Office is not free to ignore portions of the various references in a combination. Thus, the Patent Office must reconcile the thin wallet nature of O'Leary with the teachings of Turgeon and find some proof that it would be obvious to change O'Leary's thin wallet. Since the Patent Office has done none of these things, the Patent Office's implicit rejection of the claims based on Turgeon does not satisfy the procedural burdens set forth to establish obviousness. Appellant requests that the Board reverse the Examiner and instruct the Examiner to allow the claims on this basis.

## **Conclusion**

The Patent Office's efforts to show the financial information stored on the portable device fail in view of O'Leary's thin wallet model. Likewise, the use of Turgeon to supplement the failings of O'Leary is improper. Even if Turgeon is properly before the Board, the Patent Office has not justified its use with the guidelines set forth in the MPEP or by the Federal Circuit. As such, the Patent Office has not established obviousness, and Appellant requests that the Board reverse the Examiner and instruct the Examiner to allow the claims on this basis.

Respectfully submitted,

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Attorney Docket: 4989-005

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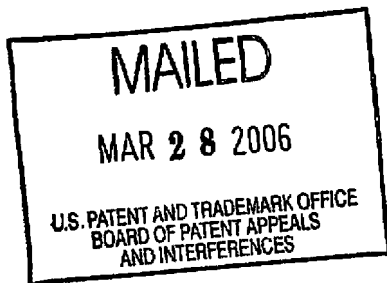
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The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE



BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

*Ex parte* SHIMON SHMUELI, ALEX LANG  
and JEAN BILLMAN

Appeal No. 2006-0989  
Application No. 09/802,634

ON BRIEF

Before OWENS, GROSS and LEVY, Administrative Patent Judges.  
OWENS, Administrative Patent Judge.

*DECISION ON APPEAL*

This appeal is from a rejection of claims 1-7, 9-19 and 21-27, which are all of the pending claims.

*THE INVENTION*

The appellants claim a portable device, a computer readable medium including software to reside on the portable device, and a method for facilitating a web-based transaction using the portable device. Claim 1, which claims the portable device, is illustrative:

Appeal No. 2006-0989  
Application No. 09/802,634

1. A portable device comprising:
  - a) a body;
  - b) memory within the body containing software and financial account information;
  - c) an interface associated with the memory and adapted to facilitate interaction with the host computing device during a computing session;
  - d) the software adapted to execute on the host computing device to instruct the host computing device to:
    - i) recognize financial account fields in a web page during a browsing session;
    - ii) fill in the financial account fields in the web page with the financial account information from the portable device to facilitate a web-based transaction;
    - iii) automatically execute on the host computing device in association with the computing session; and
    - iv) in association with termination of the computing session, instruct the host computing device to remove records pertaining to the computing session from the host computing device to enhance privacy associated with the computing session.

#### THE REFERENCES

de la Hueraga	5,960,085	Sep. 28, 1999
Rallis et al. (Rallis)	6,425,084	Jul. 23, 2002
(effective filing date on or before		Jul. 31, 1998)
O'Leary et al. (O'Leary)	6,609,113	Aug. 19, 2003
		(filed Feb. 3, 2000)

### *THE REJECTIONS*

The claims stand rejected under 35 U.S.C. § 103 as follows: claims 1, 3-6, 9-13, 15-18, 21 and 23-26 over O'Leary in view of Rallis, and claims 2, 7, 14, 19, 22 and 27 over O'Leary in view of Rallis, de la Huerga and official notice.

### *OPINION*

We reverse the aforementioned rejections. We need to address only the independent claims, i.e., claims 1, 13 and 21.<sup>1</sup> Claim 1 requires a portable device having a body with a memory therein containing financial account information. Claim 13 requires a computer readable medium including software comprising instructions for a host computing device to fill in financial account fields with financial account information stored on a portable device. Claim 21 requires the step of filling in financial account fields with financial account information stored on a portable device.

The examiner argues that O'Leary discloses at column 9, lines 15-20 that the contents of a wallet including financial information are downloaded to portable devices such as personal digital assistants and cellular telephones, and that O'Leary

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<sup>1</sup> The examiner does not rely upon de la Huerga or official notice to remedy the deficiency in O'Leary and Rallis as to the independent claims.

fills in a form using the information from the wallet (answer, page 9).

The following disclosures by O'Leary include the portion relied upon by the examiner:

As the user accesses the Internet using its Browser 210, a Wallet 215 is launched by the user. The Wallet 215 can be downloaded and installed from a website. Using thin wallet technology, the majority of software and databases comprising the Wallet 215 resides on a host web server and the user accesses the Wallet 215 through a website or a button (e.g., icon) on the Browser 210. Some functionality of the Wallet 215 can be operated on the workstation 200 itself, without the requirement of attachment to the Internet. In addition to PC-based access as described above, the Wallet 215 can be downloaded to various non-PC devices such as PDAs, cellular telephones, and interactive TV's. The consumer may access the Wallet 215 while logged onto the Internet by selecting a wallet button on the Browser 210 toolbar, or selecting a wallet icon at the merchant's web site. For non-PC devices, the Wallet 215 can be activated via a separate application, a browser link, or through a sponsoring website. [col. 9, lines 9-26]

\* \* \*

Next, in step 9C the user sets up the PPP [payment portal processor] enhanced Wallet 215 for use by choosing "Install a Web Wallet" from the menu. The user is instructed that its PPP enhanced Wallet will now be installed as a button on the browser 210 toolbar. Once the software for the PPP enhanced Wallet 215 has been installed on the user's system (e.g., the user's PC or web server), the user is prompted to provide some background information that will assist the user in making web purchases and payments. An example of some of the background information requested includes the user's shipping name

Appeal No. 2006-0989  
Application No. 09/802,634

address. At this point, the PPP enhanced Wallet 215 installation is complete and the user can perform any of the methods described above with respect to FIGS. 1-8. As previously described, using thin Wallet technology, the majority of the software and data associated with the PPP enhanced Wallet 215 resides on a server maintained by the XYZBank 965. [col. 26, lines 43-59]

Although O'Leary discloses that the wallet can be downloaded to non-PC devices, the disclosures that the wallet is accessed via a separate application, a browser link or a sponsoring website, and that the majority of the software and data reside on a server, indicate that what is downloaded to the non-PC devices is not the contents of the wallet such as financial account information but, rather, is the software needed to access the wallet.

Thus, the examiner has not established that O'Leary discloses, or would have fairly suggested, to one of ordinary skill in the art, the requirement for storing financial account information on a personal device as set forth in the appellants' independent claims. The examiner does not rely upon Rallis, de la Hueraga or official notice to remedy this deficiency in O'Leary.

We therefore conclude that the examiner has not carried the burden of establishing a prima facie case of obviousness of the appellants' claimed invention.



Appeal No. 2006-0989  
Application No. 09/802,634

### DECISION


The rejections under 35 U.S.C. § 103 of claims 1, 3-6, 9-13, 15-18, 21 and 23-26 over O'Leary in view of Rallis, and claims 2, 7, 14, 19, 22 and 27 over O'Leary in view of Rallis, de la Hueraga and official notice, are reversed.

REVERSED

*Terry J. Owens*  
TERRY J. OWENS  
Administrative Patent Judge

*Anita Pellman Gross*  
ANITA PELLMAN GROSS  
Administrative Patent Judge

BOARD OF PATENT  
APPEALS  
AND  
INTERFERENCES

  
STUART S. LEVY  
Administrative Patent Judge

TJO/gjh

Appeal No. 2006-0089

Application No. 09/802,634

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